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MANUAL —OF— OFFICE PROCEDURE

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PATENT OFFICE SOCIETY MANUAL
—OF—
DETAILS OF PATENT OFFICE PRACTICE.

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INTRODUCTION.

In order that the assistant examiner shall properly perform his duties it is necessary that he should form a just conception of his position and responsibilities with reference both to the public and to the inventor, and acquire a full appreciation of the work in which he is engaged.

A patent is sometimes regarded as a contract between the public and the inventor, the consideration on the part of the inventor being such a complete disclosure of the invention as will enable any one skilled in the art to which the invention appertains to make, construct, compound, and use the same. The consideration on the part of the public is the protection of the inventor in the manufacture, use, and sale of his invention for a definite time (17 years) by prohibiting the manufacture, use, and sale by others without the inventor's consent.

One function of the patent is to clearly and distinctly point out the exact limits of the invention for which the patentee is given protection.

This is done by the claims of the patent and hence it is to the claims that the most careful study and closest attention must be given.

In fact, the chief duty of the examiner is to see that the applicant is not granted a patent for more than that to which he is entitled. To this end all the pertinent art must be found and carefully considered.

As long as the application has not matured into a patent it is plastic and may be amended by the applicant to bring it into conformity with all Office requirements. Once matured into a patent, it is a grant with the government seal thereon, and is rigid and unchangeable, except in special instances, by reissue, disclaimer or certificate of correction. It is, therefore, of the utmost importance that all imperfections should be cured before the application goes to patent. The examiner represents the public in the drawing of this contract, but inasmuch as the object of the patent laws is to advance the arts and sciences, and this can only be done by granting to the inventor a suitable reward for his efforts, it follows

that the public is interested in extending to the inventor full protection for what he has done as well as in withholding a grant for what is not his own.

The fact that most cases of importance are prosecuted by competent attorneys may relegate this latter phase of an examiner's duties to a secondary position, but it should not be neglected. The attitude of the examiner should be that of hearty cooperation with the attorney. Both should have the same object in view, namely, the framing of the grant in such a way as to secure to the inventor protection for all that he has added to the useful arts and for no more.



Patent Office Society Manual of Details of Patent Office Practice.

RECEIPT AND DISTRIBUTION OF APPLICATIONS.

An application for letters patent is received at the Patent Office through the mail, by express, or by hand.

When the application arrives by mail or express it is received by the head of the Mail Division. The fee is entered on the face of the application papers and a book in the Mail Room and is then passed to the Financial Clerk. The model, if any, is taken to the Model Room with an identification card attached.

The petition, specification, oath, and power of attorney, if there be a power of attorney, together with the drawing, are forwarded to the Application Room.

When the application is delivered by hand it is received by the Financial Clerk who retains the fee, notes the fact of its receipt thereon, and forwards the application papers to the Mail Clerk, who sends them to the Application Room with those received by mail or express.

In whatever manner the application or any part thereof is received in the Office, the date of its receipt is stamped thereon at once. The date of receipt of the application in the Office is of the utmost importance and the examiner should note carefully the provision of Rule 12, Rules of Practice, relative to receipt of mail.

In the Application Room the application papers, with the exception of the drawing, are placed in a jacket and the data given below are placed thereon. The drawing is sent to the Drafting Division to be inspected by the Chief Draftsman. If satisfactory, he stamps "Draftsman, Patent Office" and the date on the back of each sheet. If not satisfactory, the objections are written on the face of the drawing in pencil. The drawing is then returned to the Application Room. Here it is assembled with the specification.

The Application Clerk mails a receipt to the applicant and if the drawing has been criticized by the Draftsman, he embodies such criticism therein, stating whether or not the drawing can be corrected.

THE APPLICATION.

A complete application comprises the following parts:

A petition,

A specification (with claim or claims),

An oath,

A drawing (when required),

A first fee of \$15.00,

Sometimes, but very seldom, a model (see Rules 56-61),

or a specimen is required (see Rule 62).

The application, with the exception of the drawing, of course, when placed on the examiner's desk is in a file wrapper. It was placed therein in the Application Room, and the following data written on the face of the wrapper:—

1. The serial number given it in the Application room.
2. The number of the Division to which it is assigned by the Application Division.
3. The name of the applicant.
4. The residence of the applicant.
5. The title of the invention.
6. The date of receipt of the various parts of the application.
7. The date when it is considered a complete application. (If the parts of the application have been received at different dates, the date of receipt of the last part is the date of the complete application.)





8. The name and address of the attorney, if there be an attorney.

9. The name of the assignee and his residence, if there be an assignee.

The Application Clerk assigns the application to the Division to which it belongs and an alphabetically arranged register is kept of all applications and the Division to which each is sent is made part of this record.

Every morning the applications, including the drawings, are sent to the Divisions to which they have been assigned. The Principal Examiner then takes charge of the cases and distributes them to his assistants.

As soon as received in the Division the class, and usually the sub-class, and the examiner's initials are put in lead pencil in the upper left-hand corner of file and drawing by the Primary Examiner.

The clerk of the Division inserts the page and book number of the application in the upper right hand corner when she enters the application in her register, so that if at any time the examiner wishes to get the history of the case it may be found.

The clerk also writes on the margin of the drawing the serial number of the application, the number of sheets of drawing, and the book-number alluded to above. The back of each sheet must bear the stamp of the Draftsman before the application is allowed.

Indications printed on the face and back of the file wrapper for further data to be supplied later will be referred to hereinafter.

EXAMINATION OF APPLICATIONS.

The order in which applications are taken up for examination is given in Rule 63 and in Order 2210, 1915. (Copies of Orders referred to herein may be found in the Order Book kept in each Division and in the Chief Clerk's Room; where the substance of the order is not given in the text, the order will also be found in full at the end of this pamphlet.)

Upon receiving an application from the Application Clerk, and before entering it on the register, each examiner forthwith decides whether it has been properly assigned to his Division. If in his opinion the application does not belong to his Division, and no other Division will accept it, he forwards it, together with the showing upon which he relies, to the examiner who, in his opinion, should examine it. He also fills out blank form 2-573 and has it receipted by the examiner to whom he forwards the application, and retains it as a charge. If there be more than one Division involved, each examiner in turn makes a prompt report upon the application, with the necessary showing, and the last examiner to receive it sends all the papers to the Classification Division. The examiner of the Classification Division decides the question of the proper classification of the application, attaches a card to the file directing the transfer of the application, or its retention in the original Division, as the case may be, and also encloses a statement of the grounds of his decision.

If the application is to remain where it is, no further procedure is necessary.

If the application has been assigned to another Division, the clerk records the fact in the record of the case in the "Register of Pending Applications", cancels the classification and page marks on the application file and drawing, attaches to the application a card, (Form 2-567), showing where it is assigned and forwards it to the Application Room. The transfer is recorded there and the case forwarded to the Division to which it has been assigned.

If an application contains claims to two or more inventions, and one of them belongs to the Division to which the application has been assigned, division is ordinarily required by the examiner to whom the case has been assigned as this may avoid a needless double transfer.

The application should be inspected when first placed on the examiner's desk to enable him to judge of the probability of interference with pending applications, and if such interference seems probable, a comparison with pending applications must be made. The question of possible interference must be kept in mind throughout the examination.



EXAMINATION AS TO FORM.

In reading the application over for the first time the clerical errors and the errors in English should be carefully noted. It is not a matter of importance whether the language is the best that could be chosen, but gross errors in grammar must be noted and correction required. Note in pencil all such errors on the margin opposite the points where they occur. In this connection the examiner should keep in mind Order No. 1455, Feb. 4, 1902, which requires that no erasure or any note, interlineation, or other mark, in pencil or otherwise be made, except by formal amendment, duly signed, in the body or written portions of the specification or of any other paper filed in an application for patent.

Note the requirement that all interlineations and erasures made prior to filing the papers, must be referred to in marginal or foot notes on the same sheet of paper. (See Rule 45).

Much of the work on an application relates to apparently trivial clerical details. Failure to give proper attention to these details increases the amount of correspondence, befores the issue on the important questions involved in the application, and consumes a large portion of the time that could otherwise be expended upon the merits of the case.

THE PETITION, (Rule 33).

If the post office address is omitted it must be supplied by a **letter over the applicant's own signature**. Frequently, having given his residence, the post office address is only given by street and number, it being taken for granted that the city and state is that of his residence. If such be the case, completion of the post offices address should be required, unless the application is ready for issue, when it may be allowed as it stands. The object of requiring applicant's post office address is to enable the Office to communicate directly with the applicant if desired; hence the address of the attorney with instructions to send communications to applicant in care of the attorney is not sufficient.

As to the matter of amending the petition, the best practice now seems to be to allow an attorney to amend the same with the exception of applicant's post office address, which can be inserted or changed only on applicant's request or direction.

THE POWER OF ATTORNEY, (Rules 17-23).

Usually a power of attorney is appended to the petition. In order that this power may be valid, the attorney appointed must be registered. If that is not the case, the clerk in the Application Room stamps a notice to that effect on the margin. In that case, and if, for any other reason, the power of attorney is invalid, a statement of that fact should be made, and the reason for the invalidity pointed out in the first letter; and furthermore, it should be stated that in the absence of validation of the power prior to the next Office action, further correspondence will be held solely with the applicant. An unregistered attorney may, however, appoint a registered attorney to act as his substitute. Associate attorneys whose powers have been revoked, must be formally notified of such revocation by the examiner. (See Order No. 2024, Dec. 20, 1912).

Generally speaking the death of the inventor terminates the power of attorney. Hence, an amendment signed by the attorney after the death of the inventor should be ratified by heirs, administrators or assigns.

Such an amendment may, however, save the case from abandonment. It is therefore entered and ratification is called for together with proof of authority of the one ratifying the action. See *In re Matullah*, C. D., 1912, page 490. See also pages 36 and 37 post.

At the present time a revenue stamp is necessary before a power of attorney will be recognized, but this stamp is not required when the power is executed abroad nor when to require it would necessitate its being paid for by the Government.

In connection with Rule 15, the examiner should note Order No. 2345, Aug. 16, 1917, which requires every power to inspect an application to be approved in writing by the examiner in charge of the Division before per-

mission to inspect is granted. The power to inspect must be placed in the file and it should be remembered that a power to inspect does not confer the right to obtain copies.

Attorneys and other authorized persons may have the file and drawing sent to the Record Room for their inspection, but care must be taken that the persons so ordering the files and drawings have proper authority.

No references, files, drawings, or papers pertaining thereto are to be taken out of the Division without a charge being left therefor on the clerk's desk.

THE SPECIFICATION, (Rules 34-95).

In addition to the requirements of the rules, the citizenship of the applicant must appear in the preamble. (See Chief Clerk's notice to Issue Division of Sept. 18, 1912.) Where the citizenship is given in the oath but omitted in the preamble, it may be supplied by examiner's amendment.

The statement that applicant is in the Army or the Navy satisfies the requirement of residence.

The title must be appropriate, but not too long, although the applicant is allowed reasonable latitude on this point.

In connection with Rule 40, Order No. 2018, Nov. 11, 1912, must be considered. This order states that where the application is ready for allowance, and the first name of the applicant is disclosed in the record, but does not appear in the preamble to the specification, the Primary Examiner will insert the first or Christian name by examiner's amendment. If the full first name appears in the preamble it need not appear elsewhere in the application, except that it must be written on the file wrapper. Where the first name given by the applicant appears to be a nick-name, the examiner should require that applicant furnish his first name or an affidavit that the apparent nick-name is his true first name. **Titles of individuals should be canceled.**

In case of a joint application, the order of the names on the file wrapper is that in which the applicants sign the **specification**. The order in which they sign the petition and oath, or in which their names appear in the

preamble, is of no moment, and will be corrected as to the preamble by the Issue and Gazette Division. (See under heading "The Drawings", page 15).

The general statement of invention should be brief and concise, and, roughly speaking, co-extensive with the claims. Applicant may refer to the general state of the art and the progress made thereover by his invention, but he is not allowed to make derogatory remarks concerning the inventions of others, and to designate them by name unless to state that he desires to improve on the disclosure in a prior patent or application or that he makes no claim to the disclosure in a certain application.

The specification is sometimes so vague and indefinite that a new specification should be required, but new specifications cumber the record and require additional reading, and hence should not be required or accepted except in extreme cases.

The examiner should keep before him Rule 39 while examining the preamble. In applying the provision that full names must be given, pay particular attention to Order No. 600, which says that "all applications which disclose the full name of the applicant in the preamble of the specification will be received and considered as a sufficient compliance with Rule 40", and that, "When the full first name of the applicant does not appear either in his signature or in the preamble to the specification, the examiner will, in his first official letter, require an amendment supplying the omission, and he will not pass the application to issue until the omission has been supplied, unless an affidavit shall have been filed setting forth that the full first name of the applicant is the one originally given by him".

The signature to the specification requires no witnesses.

THE OATH, (Rules 46-47).

In cases where the oath is in any way defective, note Order No. 1838, Nov. 13, 1910, which says among other things: "The oath cannot be amended and if deficient for any reason a new oath must be required." The expression "only inventor" is not the equivalent of "sole inventor" in the oath.



See that the venues and the seal of the oath agree, remembering, however, that in many states a notary public may administer oaths in any part of the state. (See John's American Notary. Copy in Law Library).

The application should be filed as soon as possible after the oath is taken and it has been held that if the application is filed more than five weeks plus the time required for transmission in the mails, a new oath must be filed. Considerable discretion is allowed in this matter and this rule does not apply to divisional, continuation, and reissue applications.

In requiring a new oath always give the reason for the requirement and state that the serial number and date of filing of the application of which it is to form a part must appear in the body of the new oath.

If the consular certificate is omitted, in cases in which the oath is taken before a notary abroad, the examiner should require a new oath, **or a consular certificate**. In all applications executed abroad, from which the required consular fee stamp has been omitted, the first requirement in the case will be that the necessary stamp be forwarded to this office to be affixed to the affidavit and canceled by the chief clerk of the Patent Office. (See Commissioner's Order 2032, Feb. 13, 1913.)

This applies only to affidavits taken before consular officers. Embassies and legations are not required to attach fee stamps to papers executed by them.

The provision in the Rules that no oath may be administered by any attorney in the case should be carefully noted.

The supplemental oath referred to in Rule 48 is not found in a new application, but occasion for it may arise in the course of the prosecution of the case. The rule clearly points out the nature of this oath, but it should be kept in mind that Rule 48 can not be used to introduce new matter into an application. It applies only to matter originally shown or described but not embraced in the statement of invention or claims as originally presented.

THE MODEL, (Rules 56-61).

The Rules give all necessary information as to the model. It may be well to state here that a model is not

directly required by the Office to demonstrate the operativeness of a device. If operativeness is questioned, the applicant is required to establish it to the satisfaction of the examiner, and he may choose his own way of so doing.

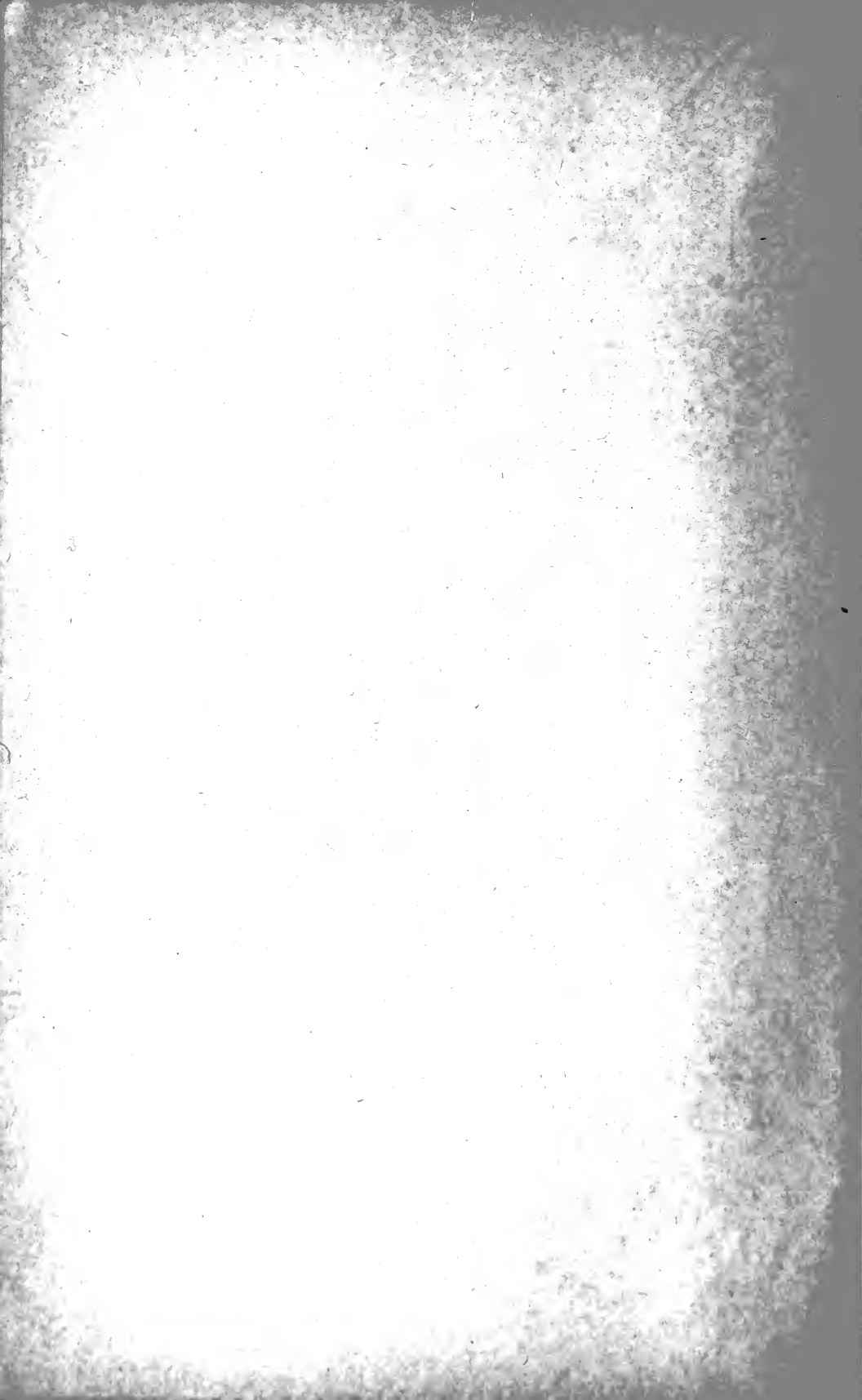
Perpetual motion devices form the only exception to this rule. In this connection attention is called to the notice promulgated by Commissioner Newton, on Jan. 30, 1918, as to the treatment of these cases. This notice provides that in all applications involving perpetual motion the Primary Examiner should write a letter to the applicant notifying him that the application involves perpetual motion and citing *ex parte Payne*, 1904, C. D., 42; that if the application were taken up for consideration as to its merit the first action would be a rejection on the ground of inoperativeness for any useful purpose; that the Office deems it fair to give applicants who believe they have discovered perpetual motion a word of warning that fees paid cannot be recovered after the application has been considered by the examiner, and that it is thought best to give the applicant an opportunity to recover the moneys paid into the Office. The letter should also state when the application would be reached for action, and advise the applicant that if he does not desire to have the application considered he should immediately return the filing receipt with a request that the filing fee of \$15 be refunded.

This letter is written on the usual examiner's letter paper (2-260) and the original placed in the file.

THE DRAWINGS, (Rules 49-55).

The examiner will find the drawing stamped on the back with the draftsman's stamp if it is correct as to formal matters. If it is not so stamped the examiner will find written in lead pencil on the face of the drawing the draftsman's objections thereto, and also a statement as to whether or not the drawing can be corrected, and the cost of such correction. If it cannot be corrected the draftsman's notation will state that a new drawing is required. The examiner should embody the draftsman's statement with regard to the drawing in his letter to the





applicant, and in so doing he should be careful to state distinctly that a new drawing will not be admitted or that a new drawing is required, in accordance with the draftsman's directions.

See that the figures are correctly described in the brief description of the specification and the reference characters properly applied, no single reference character being used for two different parts either in the same or different modifications. Every feature covered by the claims must be illustrated but there should be no superfluous illustrations.

Correction of the drawing may be made only under the supervision of, or by, the Chief Draftsman, and no such correction or alteration will be permitted in any case, except as hereinafter indicated, until after approved photographic copies of the drawings have been filed. A black line photographic or lithographic print is an "approved" copy, a blue-print is not.

The Chief Draftsman is the judge of drawings, as to the execution of the same, and the arrangement of the views thereon; while the examiner is the judge as to the sufficiency of the showing.

To avoid accumulation of canceled sheets of drawings, the examiners will not accept nor admit additional or substitute drawings, unless such drawings shall have been required in a previous consideration of the case. Examiners should not require substitute drawings in any case unless the Chief Draftsman has first indicated that the original drawings cannot be made serviceable. Where the cancellation of some of the figures from one sheet of the drawings has left the remaining figures with an in-artistic arrangement, the Chief Draftsman should be consulted as to whether the said remaining figures should be transferred to other sheets already in the drawings; and conversely, when the necessary additional illustration is but fragmentary and may be added to the drawings on file, an additional sheet of drawing should not be required, but the examiner will ask that the proposed illustration be shown in a sketch, which showing will be transferred to one of the sheets of the drawings.

In joint applications, the names of the applicants should appear on the drawing in the order in which they

signed the specification. If not, the Office will remedy the defect at applicant's request if the names were signed by the attorney. If the names were signed by the applicants, the drawings are ordinarily returned for correction. In the latter case, as in all instances where the drawing leaves the Office, a photographic print must first be placed on file.

The examiner, when he finds correction of the drawing necessary, should explain the correction and require the applicant to furnish a sketch in permanent ink of the correction to be made, and file a request that the Office draftsman make such correction. If applicant does so, the sketch is submitted to the examiner for his written approval, and, if given, a print is made of the drawing as it originally stood, and placed in the file. The correction is then made by the draftsman.

Applicant's request for a change in the drawing should be accompanied by a sketch of the proposed change with the request that the change be made. The sketch must be in permanent ink and should be placed in the file. The procedure is the same as above. The correction is at the expense of the applicant, and when the Office does not require the change the print of the original is also at his expense.

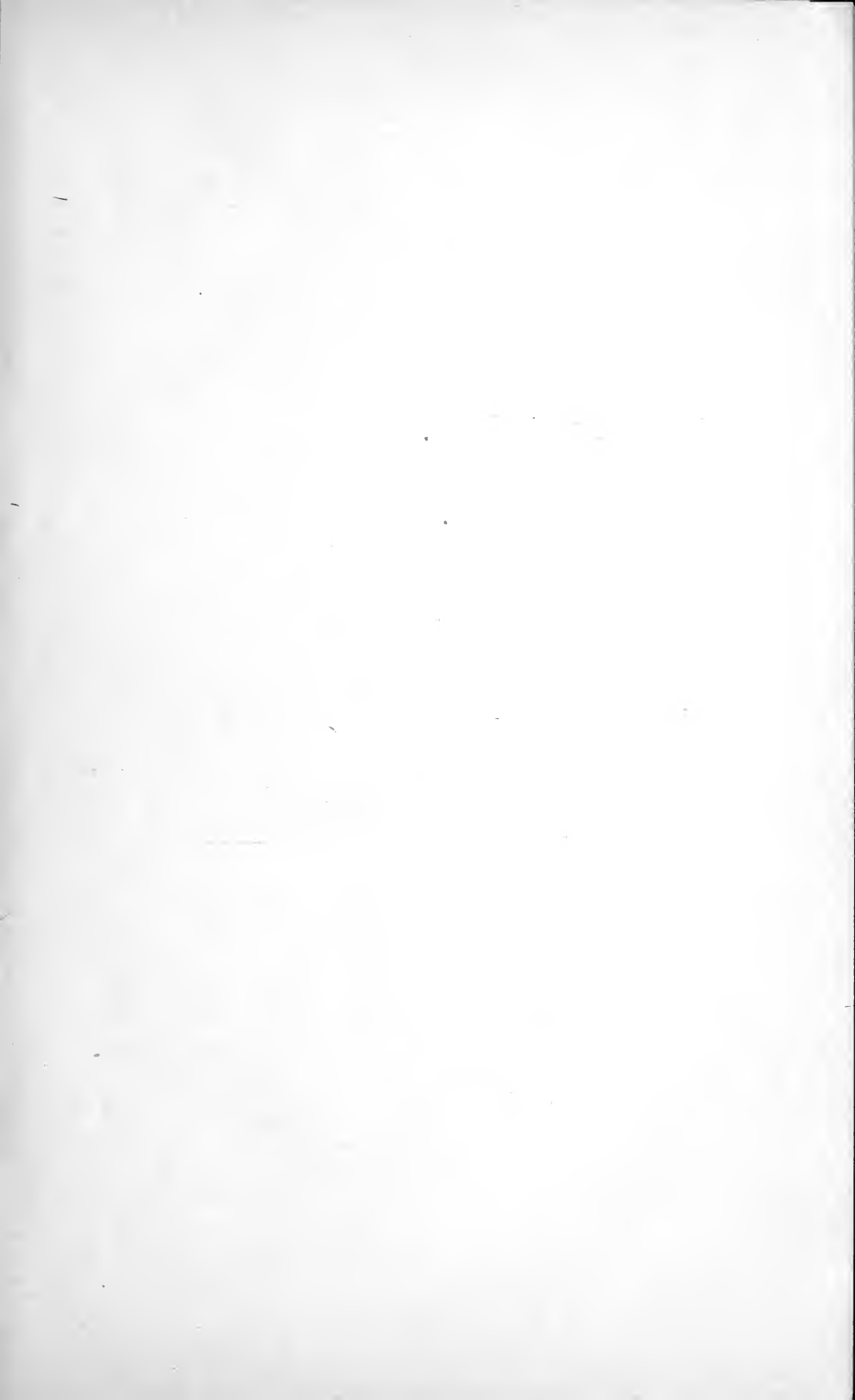
A print is not required for the following changes:—

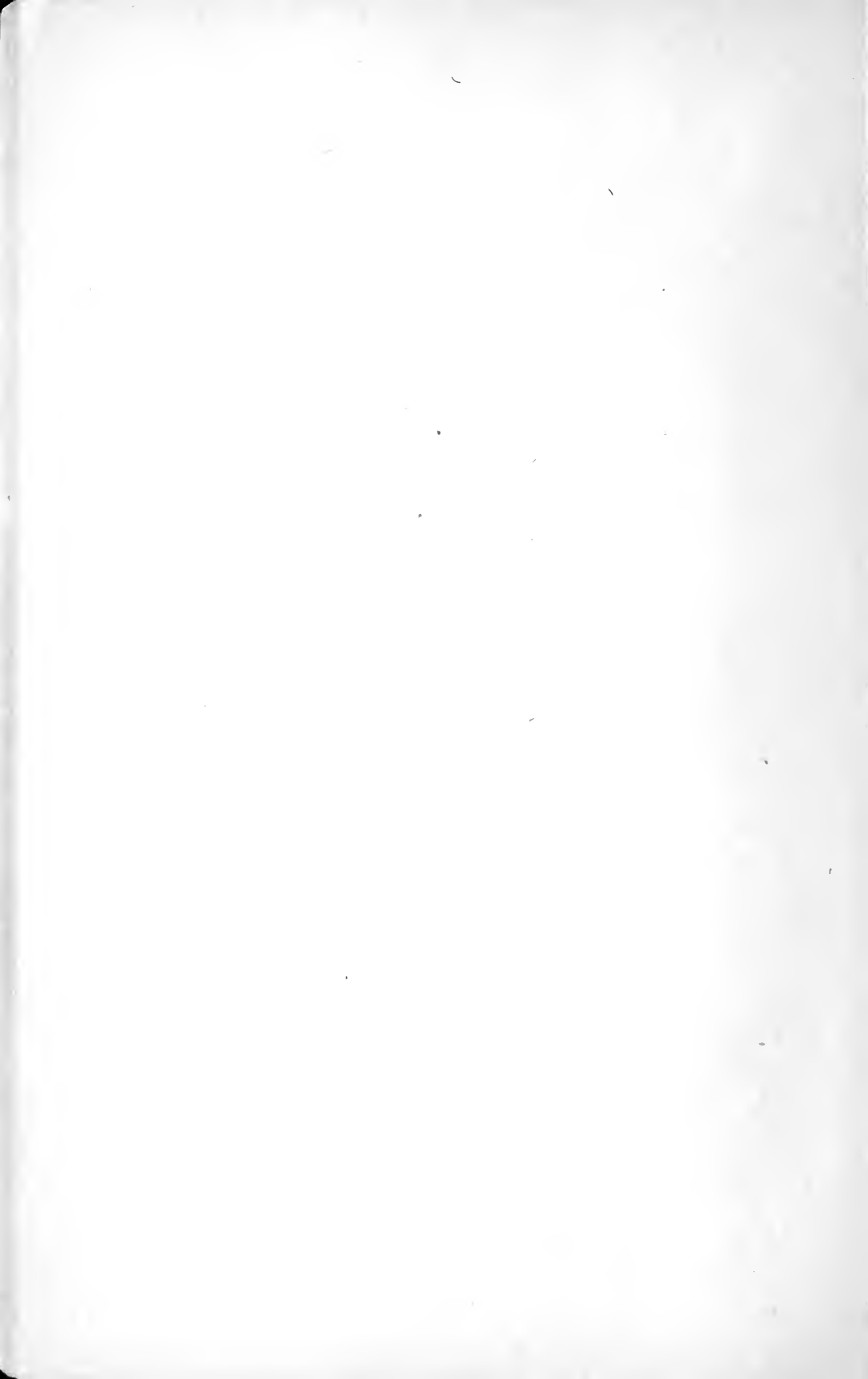
- To add a few reference characters,
- To change the ordinals of the figures,
- To correct the name of the inventor when written by the attorney, or
- To add section lines and their numerals.

These changes may be made by the draftsman on the examiner's request. (See Order No. 2583, June 14, 1920). An examiner's amendment authorizing these changes should, however, be entered in the file.

See notice of June 14, 1920, which also says:—

"To expedite the execution of orders to correct or change drawings, it is directed that all letters received in the Drafting Division requiring a change in the illustration of structure, be delivered to the proper examiner for his inspection and approval. Whether the examiner approves or disapproves the change, the letter directing the same, with the examiner's recommendations, will be attached to the file and drawing and immediately sent to the Drafting Division for action."





To avoid the withdrawal from the examining divisions of files and drawings for a long time, the draftsman should retain the file and drawing only long enough to make an estimate of the cost, after which they should be returned to the examining division with an order for the work attached to the drawing. When the case is reached in its regular order in the draftsman's division it will be called for by the draftsman and the corrections made. (See Notice of July 13, 1906.)

The present practice however, is to retain the file and drawing in the draftsman's room whenever the money is on hand to pay for the changes. When this is not the case the file and drawing are returned to the examining division until the money is received.

EXAMINATION AS TO MERITS.

Having noted all objections of the character above described, the application is next to be examined as to its merits or substance.

Sec. 4886, R. S., reads in part as follows:—

“Any person who has invented or discovered any new and useful art, machine, manufacture, or composition of matter or any new and useful improvements thereof, . . . unless the same is proved to have been abandoned, may upon payment of the fees required by law and other due proceedings had, obtain a patent therefor.”

The part of the statute omitted is of the utmost importance, but it does not add to the conditions of patentability as it in fact forms a definition of what is meant by the term “new” in the statute. It does this by stating the conditions that negative novelty.

Secs. 4888-4892 inclusive, state the steps which must be taken by the inventor to secure a patent when he is entitled thereto.

The examination, made under the provisions of Sec. 4892, is then to ascertain two things: 1. Is the applicant entitled to a patent?, and 2. Has he taken the steps required by the statute to obtain it?

The applicant must be the inventor or discoverer. (See exceptions under Sec. 4896, R. S.)

The invention must be an art, machine, manufacture, or composition of matter, or an improvement thereof. If the subject matter of the application does not belong to one of these classes, e.g. the design of a house, *ex parte Lewis*, 54 O. G., 1890, the claims should be rejected as being for subject matter not entitled to protection under the patent law.

The subject matter of the application must be useful. To be useful a device must be capable of construction, and must be operative, as also an art must be capable of being carried out and must produce the intended result. The subject matter must not be contrary to good morals or public policy.

For any of these reasons the claims would be rejected for lack of utility.

It is required of the applicant, (see Sec. 4888 R. S.), that he shall file in the Patent Office a written description of his invention or discovery and of the manner and process of making, constructing, compounding, and using it, in such full, clear, and concise, and exact terms as to enable any person skilled in the art or science to which it appertains, or with which it is most nearly connected; to make, construct, compound, and use the same; and in the case of a machine he shall explain the principle thereof, and the best mode in which he has contemplated applying that principle, so as to distinguish it from other inventions.

As this forms the consideration on the part of the inventor in return for which he receives protection, the examiner should be careful to see that the description is full, clear, and concise, and call upon the applicant for all necessary additions or amendments.

Sec. 4888 R. S. also requires that the applicant shall particularly point out and distinctly claim the part, improvement, or combination which he regards as his invention or discovery.

The portion of the application in which he does this forms the claim or claims. This is the most important part of the application, as it is the definition of that for which protection is granted.

There is no set form for claims, but in every particular in which the claim fails to define correctly applicant's





invention, it should be challenged and the fault definitely pointed out.

In the examination of applications of the same applicant for the same general subject matter, the examiner should note whether any of the applications are assigned. If so, he should proceed as set forth in *ex parte Mc Laughlin*, C. D., 1891, page 67.

CLASSIFICATION.

Before proceeding with the examination for novelty, some knowledge of the system of classification is necessary, though it is not advisable at this point to attempt to make a close study of that intricate subject.

Pages 5-9 of the "Manual of Classification of Subjects of Invention of the U. S. Patent Office", (revised to Jan. 1, 1916), should be carefully read. If the examiner is to work on a reclassified class, the definitions of that class in the "definitions of Revised Classes and Sub-Classes of Subjects of Invention of the U. S. Patent Office" should be studied.

The division in which any class is examined may be ascertained by consulting the Manual of Classification, pages 16-18.

The examiner will find that all patents previously issued are arranged in shoes bearing appropriate labels showing the class, sub-class, and probably the lowest and highest numbered patents put in the shoe. The patents, (the term used for convenience to signify copies of the specifications and drawings), should be arranged in numerical order. The importance of keeping every patent in its proper place cannot be overestimated. When patents are taken out of the shoe cases in the course of the examination of an application, it is best to return them as soon as the examination of the application is finished, and this should be done by the examiner. He will find some copies marked "cross reference". These are patents which are classified in some other class but which have some relevance to the class in which the cross reference is placed. If numerous, these should be kept in shoes used for cross references only, and so labeled.

In the shoes are found, at the end of many classes, a

“search card”, with certain other classes or sub-classes thereon. These are to guide the examiner to other classes and sub-classes which may contain relevant matter, and he should search these additional classes in examining an application, if there appears to be any probability of finding matter bearing on the application in hand. This card is not, however, to be understood as limiting the examiner’s search to the classes named.

There are some publications kept in every division and the examiner should ascertain what they are and whether or not any of them are likely to bear on the class which is assigned to him. There is also a Scientific Library in the Office, with which he should acquaint himself sufficiently to know when it is likely to afford him assistance in his examination of an application. In this library may be found copies of foreign patents when the examiner is unable to find in its proper place one whose number and date he knows.

The English and the German Patent Offices publish “Specification Abridgments”, and “Auszüge” respectively, of the patents issued by them and these are found in bound volumes in the library.

The advantage of these bound volumes is that the abridgments and “auszüge” are arranged in classes.

The English abridgments are in the most accessible form in that all of a class for a given year are found in a single volume. The German “auszüge” are in weekly installments.

A pamphlet entitled “Guide to the Search Department of the (English) Patent Office Library”, is published by the English Patent Office, and a copy is in the U. S. Patent Office Library. Appendix I of this pamphlet consists of a concordance of English, United States, and German classes. The information therein is invaluable and should be used in the search for English, and German references. The examiner should have a typewritten copy of such parts thereof as relate to the class he examines. A pamphlet entitled “Alphabetical Index to the Classification of German Patents”, and a set of German patents bound in classes, are also kept in the Scientific Library. Austria, Denmark, Holland, Hungary, Norway, and Sweden follow the German classification.



The dates of publication of foreign patents as relied upon to establish a *prima facie* case are:—

AUSTRIA—"Ausgegeben" date;
CANADA—Date of grant;
DENMARK—"Udstedt" date;
FRANCE—"Delivre" date;
GERMANY—"Ausgegeben" date;
GREAT BRITAIN—Date of acceptance of complete specification;
HUNGARY—Date of Publication;
ITALY—Not published since 1893;
JAPAN—Date of publication;
NETHERLANDS—"Dagteekening" date;
NORWAY—"Offentliggjort" date;
RUSSIA—Large type at upper right hand corner;
SWEDEN—"Offentliggjort" date;
SWITZERLAND—Consult Swiss Patent-List.

The examiner may have patents come to his notice which have been wrongly classified. In such cases, Notice dated Feb. 20, 1918, and Order No. 2207 are pertinent.

Examiners shall not transfer official copies of specifications and drawings from one class or sub-class to another except with the approval of the Examiner of Classification.

A Law Library is also maintained in the Office where important publications on Patent Law are found. Volumes of the "Commissioner's Decisions" are found there and a set is kept in every division. These "Commissioner's Decisions" contain not only the decisions of the Commissioner of Patents, but also those of the Courts in patent cases. Unpublished or "Manuscript" decisions of the Commissioner of Patents are found recorded in a set of volumes kept in the Docket Room.

When an examiner desires to transfer domestic patents from one class or sub-class to another, he should list the patents on triplicate transfer blanks, (2-566), stating thereon what class and sub-class the patents are in, and the class and sub-class to which they are to be transferred. This slip is forwarded with both examiner's and draftsman's copy of the patents to the Classification

Division. If approved, the class and sub-class on the patents are corrected in all revised classes, the registers revised to agree with the new classification, and the copies of the patents sent respectively to the examiner's and attorney's rooms.

If the patents transferred are placed in classes not yet revised, the correcting of the class and sub-class on the patents is done in the examiner's room. One page of the triplicate slip is sent by the Classification Division to the examiner to whom the patents are transferred, one to the Chief of the Publication Division to enable him to correct his records, and one is kept by the Classification Division. Where the transfer is from one division to another, the examiner should make a fourth copy of the list to be forwarded to the Classification Division, and by them sent back to the division from which the patents were transferred.

When it becomes necessary in the course of a transfer to remove draftsman's copies from the files in the attorney's rooms, a red dummy a little longer than the copy is substituted therefor, and the identification data of the patents withdrawn are written thereon. This dummy is corrected as the patents are returned and when all are returned the dummy is removed.

If the entire sub-class is transferred, (see Order No. 1996, July 24, 1912), in an unrevised class, the examiner is required to notify the Classification Division of the fact that the proposed transfer includes all patents therein, in order that the sub-class in question may be officially abolished by the Commissioner, and its number and title removed from the Manual of Classification.

The procedure with respect to the distribution and transfer of foreign patents is fully set forth in Order No. 2207, June 23, 1915, which should be consulted.

Complete copies of patents are exchanged with the following countries:—Australia, Denmark, France, Great Britain, Holland, India, Japan, Norway, Sweden, and Switzerland.

War conditions interrupted exchanges with Germany, Austria, Hungary, and Russia.

Briefs of patents are received from Belgium, and illustrated briefs from Canada. Those from Canada are sent to the appropriate divisions where they are marked and



sent to the paste-room to be mounted, those not needed being discarded.

The Italian Industrial Bulletin, which is received here, contains titles of inventions and names of inventors. The Italian Patent Office formerly sent copies of patents, but these are no longer published.

An assistant examiner should be on the alert to note foreign patents which are exact duplicates of domestic patents, or duplicates of other foreign patents. Such duplicates must be thrown aside and not placed in the shoe cases, as they needlessly lengthen the search. In doing this, however, care should be taken to retain the patent having the earliest date.

THE EXAMINATION FOR NOVELTY.

The examination for novelty must next be made; and turning to Section 4886, R. S., the conditions that negative novelty are stated as follows: "Known or used in this country before applicant's invention or discovery thereof; patented or described in any printed publication in this or any foreign country before his invention or discovery thereof, or more than two years prior to his application; in public use or on sale in this country for more than two years prior to his application."

It is the purpose of the examination for novelty to ascertain whether or not any one of these conditions exist. Any document or material thing establishing the existence of any one of these conditions is called a "reference". Where to search for these references has already been pointed out. (See pages 19, 20). The data to be given in the Office letter is stated in Rule 66, Rules of Practice. In citing German patents, the class and subclass according to the German classification should be added to this data. (See Commissioner's notice of Oct. 5, 1915.) In citing foreign references give number of sheets of drawing, and designate the sheet or sheets referred to. For the procedure in division and election of species, see page 42 post; see also Rule 75.

Before beginning the search, the examiner should thoroughly digest the subject matter of the application, and of the claim or claims. He should endeavor to fix

in his mind as clear a conception as is possible, of the means which the applicant is attempting to claim.

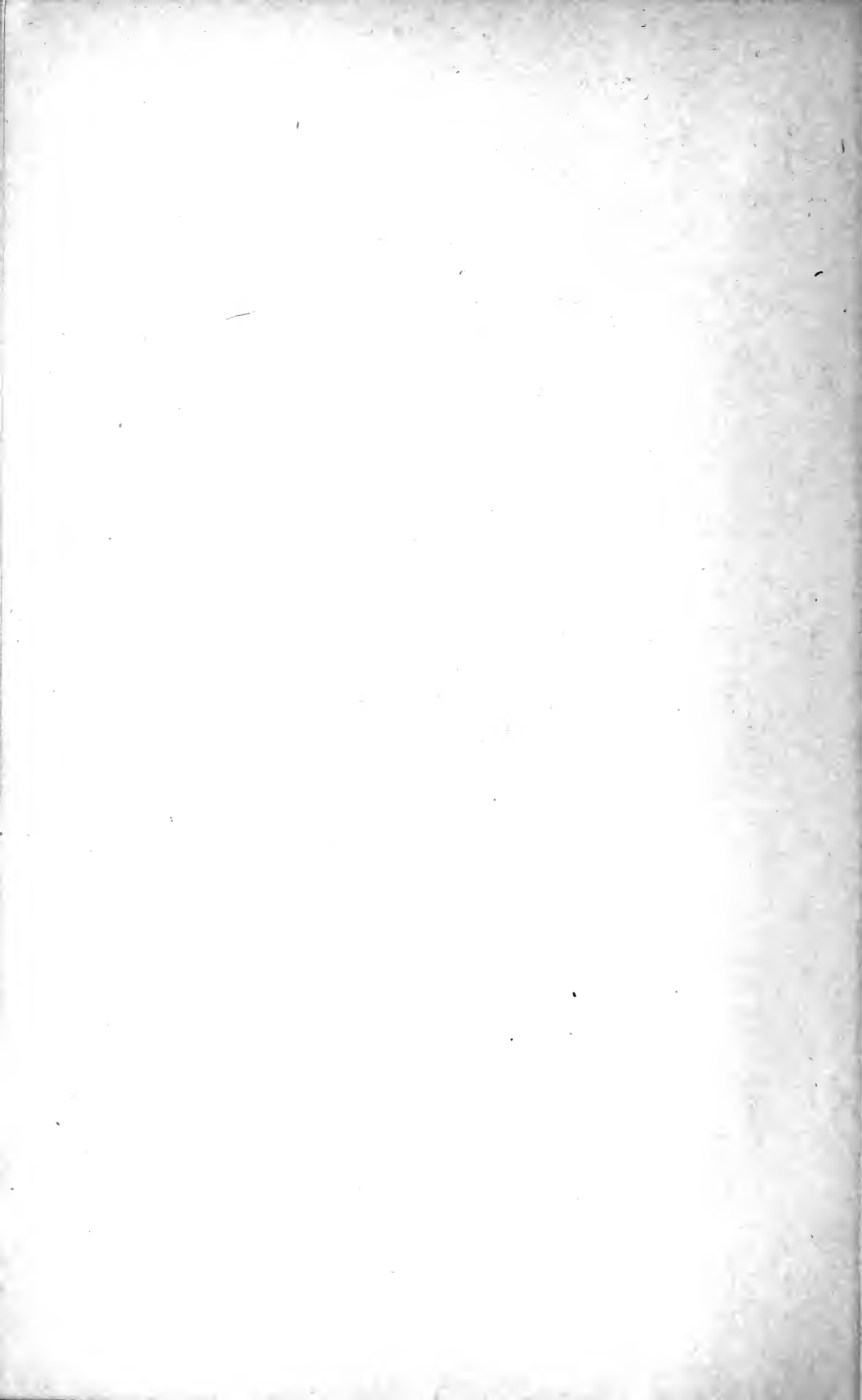
The search should then be directed to that means. As Rule 66 requires the examiner to cite the best references at his command, he should not desist from his search merely because he has found references that meet the claims presented, but should persist until he has discovered the reference that is nearest to the particular means disclosed. Where a means within the definition of the claim is not found, but, in the course of the search, a reference is found which would meet it if more broadly expressed, attention should be called to such reference in order to apprise the applicant of the precise scope of protection the prior available art permits.

When searching a broad claim the examiner should banish from his mind the particular construction shown, and attempt to visualize other forms to which the terms of the claim may apply, and thus be able to recognize the indefinite nature of a claim which, when read with the particular structure in mind that has been illustrated in the application, seems to be definite and allowable.

If the examiner while searching in divisions other than his own, finds a domestic patent he wishes to use he will take note of the data thereon, (class and sub-class, number, date, name, and title); but copies of patents should never be taken from one division to another. On his return to his division he will obtain an order blank, (No. 2-607), and fill it out with the number of the patent, and put it in the place designated in his division for it. Messenger boys come by at regular intervals to take up these orders. They "pull" the copies from the files kept by the Office, and return the blank with a copy of the patent attached. In emergency cases the orders may be sent at once to the Chief of Division F who will approve them and permit the bearer to present them to the copy pullers assigned to the territory where the copies are stored for immediate execution by the latter.

Only those assigned to Division F have access to the files of printed copies of patents. (See Order No. 2528½, June 11, 1920). Copies of patents retail at ten cents a copy and economy should be exercised in their use. It is advisable to place in the application file any copies or-





dered for it. This will avoid a duplicate order when the application is amended.

If the examiner finds a foreign patent in a division other than his own, he may write out his deductions concerning it on the spot; he may take the data and look at the patent in the library; or he may borrow it, **leaving a charge therefor** with the clerk of that division. If he thinks that the foreign patent would be of frequent use to him in his own class, he may obtain a photo-lithographic copy of both specification and drawing by filling out a request therefor on a blank, (No. 2-247), obtainable from the clerk of his division, and having the principal sign it before sending it out. The request is put in a box he will find in his division marked "Division E", and the copy will be delivered in the course of a few days.

For the classification of a domestic patent not stamped on the copy at hand the Classification Division should be consulted.

Foreign patents are arranged very differently in the various divisions of the Office. Whatever the arrangement in his division, the examiner should be sure to refer to the specification for every feature in the drawing he does not thoroughly understand.

In the treatment of an application it is sometimes necessary to inspect the application papers of some previously granted patent. These may be obtained in the Record Room by filling out slips (Form No. 2-126, or 2-125, according to whether or not the papers are to be taken from the room) found there, with the necessary data and giving them to the clerk in charge. The application papers are drawn from the shelves and distributed, the slip being retained by the clerk as a charge. The application papers should be promptly returned when the examiner has finished with them.

The data of a patent are sometimes accessible but no copy of the patent convenient. When this is the case the examiner can find the patent in the bound volumes of all patents granted, kept in the Record Room.

While the search will sometimes carry the examiner into other divisions, he must remember that examiners are permitted to enter another division only when some member of that division is present. The examiner will

examine the shoes designated in that division just as he examines his own.

When there are found in an application in which division would not be required, claims, the references for which must be sought entirely in another division, the examiner may write a letter to the primary examiner of the other division requesting a search on such claim or claims. This letter is forwarded with the file and drawings to the other division in which the search is to be made; and, following the search, the papers are returned with a report thereon.

The search having been made, the examiner will make an indorsement on the left hand page of the open file wrapper, stating the classes and sub-classes of domestic and foreign patents, and the publications in which search for references has been made, and also the date of the search.

EXAMINER'S LETTER.

Before writing his first letter the examiner should examine the blank form, (2-260), on which letters are type-written.

The objections to the specification and claims should be pointed out with exactness, and the page and line, or claim and line stated. Everything of a personal nature must be avoided as also must everything which would cast a shadow on the patent if granted, as, for example, a statement that "every doubt has been resolved in favor of the applicant in granting him the claims allowed". If the attorney is discourteous in the remarks or arguments of his amendment, either ignore it entirely or submit the paper to the Commissioner to be returned. (See Rule 22a).

In rejecting a claim, use the term "reject". The reference, if not perfectly obvious to one skilled in the art, should be applied by showing what elements of the reference answer to the various elements of the claim. If more than one reference is used against a claim, state clearly what element or elements of the one are combined with, or substituted for, designated elements of the other. State clearly whether the elements of the reference meet the elements in fact and in terms, or whether they are





considered as equivalents. (For data of patents to be given in the Office letter, see Rule 66, Rules of Practice and page 23 ante. Care must be taken to cite a reissue as such).

Mention each claim in the letter. If the claim is objectionable in form, but the subject matter is allowable, the latter fact should be stated after the objections have been pointed out. Claims neither objected to nor rejected should be stated to be allowable.

Before or after writing the rough draft of the letter the application must be submitted to the Primary Examiner. The assistant examiner should understand thoroughly every point brought out in the application and he should have a complete knowledge of each reference he proposes to submit to the Primary Examiner before reporting the case. Otherwise there is a great waste of time in going over the case.

The Primary Examiner having approved the rough draft it is attached to the file and placed on the copyist's desk. She then copies the letter on the proper forms, inserting in the proper place the address of applicant or attorney and the identification data of the application, leaving a wide margin on the left hand side of the page (see Chief Clerk's notice, May 18, 1920). See that all letters in amended case begin with "In response to amended case begin with "In response to amendment (or letter) filed - - -." (Giving date of the amendment). A carbon copy is also made. The original copy, together with the rough draft, is then put on the assistant examiner's desk, who will compare the copy with the rough draft, paying particular attention to the data of the references. If any corrections are to be made, he will note them in lead pencil and return the copy to the copyist, who will make the corrections both in the original copy and carbon, and give the original copy to the assistant examiner. When the corrections have been properly made, or when there are no corrections required, the assistant examiner will initial the original copy and return the same to the Primary Examiner for his signature. The assistant examiner should see to it that all of the references are returned to their proper places before taking up a new case.

The copyist, having taken the original copies from the

Primary Examiner's desk, and having seen that all of them are signed, places them in the file wrappers on the right hand side, and enters in black on the outsides of the wrappers, under "Contents", the character of the action. If any claim has been rejected, the word "Rejection" is entered on the file; otherwise the word "Letter" is used. A requirement for division is also noted. Errors will be avoided if the examiner enters the character of the action on the file in lead pencil before giving the file and rough draft to the copyist. The papers are numbered, and as the application papers are considered No. 1, the first Office letter is almost invariably No. 2. The copyist also mails the carbon copy to the proper address.

The file is then given to the clerk, who enters the character of the action, and the date thereof, in the "Register of Pending Applications", after which the file is returned to the file case along with other cases awaiting action by the applicants. The cases awaiting action are filed in numerical order according to their serial numbers, in order that they may be readily available.

Letters are sometimes returned to the Office because the Post Office has not been able to deliver them.

The examiner should use every means to ascertain the correct address and forward the letter again after rectifying it. An office letter should be added stating that the original letter has been mailed and returned. A copy of this second letter should be placed in the file, and the year running against the application begins with the latter date.

If the Office is not finally successful in delivering the letter, it is placed, with the envelope, in the application which is filed away in the pending files.

In case a notice of allowance is returned a new notice is sent, and the file is obtained from the Issue and Gazette Division, and the date of sending the notice corrected.

AMENDMENTS AND AMENDED APPLICATIONS, (Rules 68-78).

As the specification is never returned to applicant under any circumstances, he usually retains a line for line





copy thereof. In amending, the attorney or the applicant requests insertions, erasures, or alterations, giving the page and the line. The amendments reach the Office by mail, or they may be deposited in the Application Room, or in a box at the main entrance to the Patent Office. A date of receipt is stamped on all amendments and other communications. The mail clerk of the Patent Office sends to the Post Office for all mail at the close of Office hours. This is brought to the Patent Office, and stamped as of that day. (See Rule 12). Ordinary mail arriving at the Post Office thereafter will not be received at the Patent Office until the next day. The box at the main entrance is left open until twelve o'clock at night, when it is closed by the watchman. The key is held by the mail clerk, and he has the box opened at nine o'clock in the morning, and the contents stamped as received the preceding day. All telegrams and special delivery letters received after Office hours are deposited in this box. On Sundays and holidays, telegrams and special delivery letters, this box being closed, may be deposited with the watchman, who stamps them with the date of the day received. If that date is a holiday, the mail clerk gives the amendment the same Office date stamp, but if that date is on Sunday, the mail clerk gives the amendment the date of the following Monday. The matter of the date is of importance in connection with the question of abandonment. (See Rules 31, 77, and 171).

When the amendments reach the Application Clerk, he assorts them according to the division to which they belong, and each morning sends them, together with such new applications as have been received, to the proper division. Upon receiving the amendments, the Primary Examiner makes an inspection thereof, and turns them over to the clerk, whose duty it is to enter the amendments. The clerk stamps the amendment with the date of its reception in the division. It is important for the assistant examiner to carefully observe the distinction which exists between the stamp which shows the date of reception of the amendment in the division, and the stamp bearing the date of receipt of the amendment by the Office. The latter date should always be referred to in writing to the applicant with regard to his amendment.

The clerk will not enter the amendment: 1. If it is not properly signed by a person having authority to prosecute the case; 2. If it is made after a final rejection and consists of more than a cancellation of the rejected claims; (the latter is entered, however, if it places the application in condition for allowance); 3. If it requests the substitution of an entire specification; 4. If it is received in the Patent Office after the expiration of the year allowed applicant in which to amend; 5. If it is so worded that it cannot be entered with positive accuracy; 6. If it cancels all of the claims without substituting new claims; 7. If the application to be amended is not within the Primary Examiner's jurisdiction.

When a telegraphic amendment is received it is placed in the file, and applicant notified to ratify it by a properly signed amendment. If he fails to do so, the telegram is not considered as in any way a response to any former Office action. If he does ratify promptly, the amendment may be entered. See *ex parte Wheary*, 197, O. G., 534.

If an amendment in other than permanent ink is filed, it is entered, but a permanent copy is required to be filed.

All amended cases when put on the assistant examiner's desk should be inspected at once to see if the amendment was received in the Office, (not date received in the division), within the year allowed by law for responsive action, and also to determine whether or not the amendment is apparently completely responsive. Note that this year includes the corresponding date of the succeeding year; i.e., if the Office letter was mailed March 20, 1918, a reply received March 20, 1919, is within the year.

If the amendment was received after the expiration of the year, the examiner should obtain from the Mail Room, and place in the file, the envelope in which the amendment was received. (See notice of Nov. 18, 1916.) He should notify the applicant or attorney at once that the application has become abandoned. The amendment is indorsed on the file wrapper but not formally entered. (See order No. 1854, May 10, 1910.) § See Notice of June 18, 1920, which is as follows:



"Where an amendment is filed after the expiration of the year, accompanied by a statement as to the reasons for delay, that statement should be forwarded to the Commissioner as a petition to revive, even though not so entitled."

and see post page 40.

Amendments are sometimes received in a division to which they do not properly belong. If it is not clear to what division the amendment should have gone, the information may be obtained from the Application Clerk, and the amendment should be forwarded at once to the proper division.

To return it to the Application Room, to be sent to the proper division, leads to unnecessary delay. Such delay may have serious consequences, especially if the amendment was received toward the end of the year allowed applicant for action on the case.

This general policy should be carried out with all papers received in a division, which do not belong to that division.

If an amendment is not a complete response to the previous Office action, the attorney should be notified that the amendment has not been entered for that reason, and the statement added that the year running against the application dates from the previous Office action, being careful to include said date. This statement should be emphasized by writing it wholly in capital letters, or by underlining. The examiner should not fail to consult Order No. 1961, Mar. 1, 1912, in this connection. If the incompletely responsive amendment belongs to an application coming under Commissioner's Order No. 2210, and insufficient time remains to complete the response, the case is referred at once to the Law Examiner.

If an amendment is signed by an attorney whose power is not of record, he, as well as the applicant, should be notified that the amendment cannot be entered.

If an amendment signed by the applicant is received in an application in which there is a duly appointed attorney, the amendment should be entered and acted upon. Attention should be called to Rule 7, and a copy of the letter should be mailed to the applicant, as well as to the attorney.

Where a power of attorney is given to a firm stated

to consist of certain members, an amendment signed with the name of one of the members is not entered, but is regarded as an improperly signed amendment.

Where the power is given to several individuals by name, and they are stated to constitute a firm whose title is given, an amendment signed with the name of any one of the individuals or of the firm is regarded as properly signed.

In the case of unsigned or improperly signed amendments, the amendment should be returned for signature, except in those cases where, because of the impending expiration of the statutory year, insufficient time remains for the return of such amendment. In such case the examiner will endorse such informal amendment on the file wrapper and notify the applicant of the status of the case. (See Order No. 1961, above alluded to).

An amendment signed by an assistant in the Office of the attorney, the latter having died, may, with the approval of the Commissioner, be admitted, subject to future ratification.

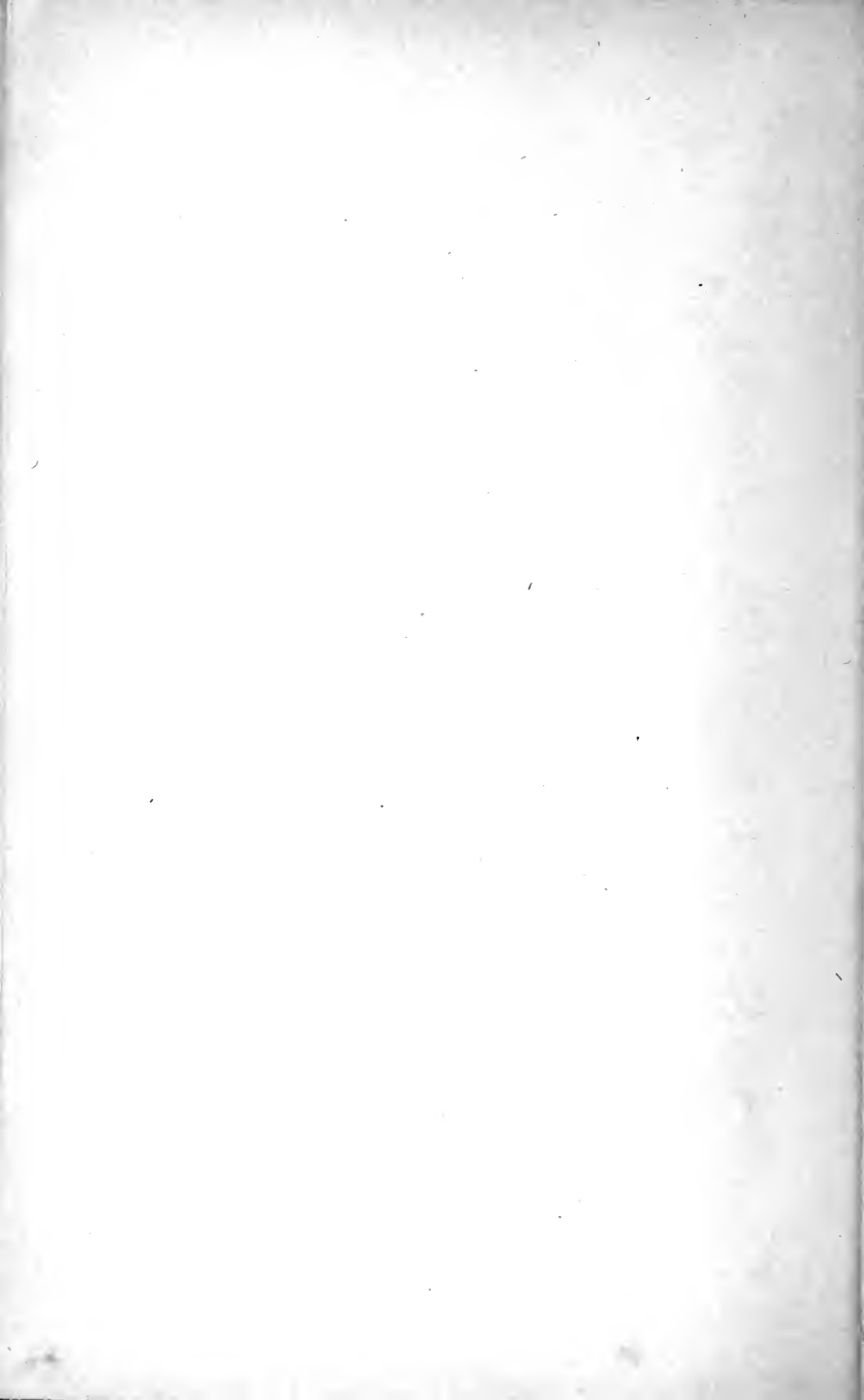
When for any reason an amendment is to be returned, sufficient time remaining therefor, before the expiration of the statutory year, it will be forwarded to the Chief Clerk with a memorandum giving the name and address of the attorney, the date of the last Office action in the case, and a statement as to why the paper is to be returned. The Chief Clerk will cancel the impression of the receiving stamps and conduct the correspondence incident to the return of the papers.

If the clerk inadvertently enters the amendment when it should not have been entered, such entry is of no effect, and the same action is taken as if the changes had not been actually made, inasmuch as they have not been legally made. The proper endorsement on the file wrapper is then "Proposed Amendment".

Those amendments that are not open to any of the above objections are entered by the clerk according to the instructions given in Order No. 1733, July 19, 1907, which should be thoroughly familiar to the examiner.

Many attorneys have offices or representatives in Washington and it sometimes expedites business to interview them concerning an application. When the examiner believes the progress of the application would be ad-





vanced thereby, he should call up the attorney in the case by telephone and ask him to come to the Office, giving him the room number, and the data of the case. The examiner may also reach the attorney by telephoning to the record room, where at the examiner's request, a notice will be posted asking the attorney to call.

The amendment or letter is placed in the file, given its number as a paper in the application, and its character endorsed on the file wrapper in red ink. The application is now "up for action", and it is very important that it should be kept separate from those applications which await action by the applicant. It is placed on the examiner's desk, and he is responsible for its proper disposal. When reached in regular order the application is re-examined. (See Rules 65 and 67).

In this re-examination, attention must be paid to new matter. Applicant is not allowed to introduce into the application any matter by amendment not disclosed in the application as originally filed, and if this is done by amendment, he must be required to cancel such matter. The examiner should note that this applies to what are called preliminary amendments; that is, amendments filed prior to an Office action on the case, even if such amendment be filed on the same day as the application. Amendments to the drawing held by the examiner to contain new matter are not entered until the question of new matter is settled.

The examiner should first note whether the character of the amendment is such as to entitle applicant to the re-examination provided for by the statutes, (See Rule 69). If not, he should inform the attorney that the amendment has not been entered, and the reason why. He should state at the end of his letter that the year running against the application dates from....., (giving the date of the preceding Office action). This notice should be typewritten in some noticeable manner, as has heretofore been suggested.

When an amendment to an application in interference is filed, the procedure is as set forth in Order No. 1759, April 17, 1908. (See page 50, post).

After re-examination and reconsideration, the examiner writes the applicant his conclusions, and the prosecution of the application is thus continued until the application

is in condition for allowance, or until either some or all of the claims are finally rejected. There may also be some formal matter on which the examiner and attorney cannot agree. In the latter case, applicant may petition the Commissioner, while in the case of a final rejection of the claims, he may appeal to the Board of Examiners-in-Chief. (See Rules 133-142.)

When the application is apparently ready for allowance, the examiner makes an "interference search". To do this, he inspects all the pending drawings in the class and sub-class in which the application is classified, and all other classes which he has found it expedient to search for references, **whether in his division or elsewhere**, in order to ascertain whether other applicants may not be claiming substantially the same subject-matter he is allowing. When the drawings show such a condition to be likely, he examines the corresponding file. The procedure in case the examiner concludes that an interference in fact exists is set forth in a subsequent section.

It should be noted that the examiner should be on the watch for indications of interfering claims throughout the examination of a case, and make a record of the same. This record, if made on the drawings, must not be such as to give any hint to the applicant, who may inspect the drawings at any time, of the date or identity of the supposedly interfering applications.

ALLOWANCE.

If no interfering application is found, the examiner should prepare the case for issue. If the application in question is in a revised class, he will first fill out the blue slip, (Form 2-574), with the exception, of course, of the patent number, and pin it to the upper left hand corner of the drawing, being careful to insert the pin outside of the margin line. In order that the revised classification of patents may be maintained in an up-to-date condition, the assistant examiners must be the main reliance of the Office in the constant exercise of teamwork and cooperation with other divisions of the Office to attain that end. In filling out the blue slip for his own class, the assistant examiner should call the attention of the proper principal examiner or the examiner of



classification to such other class or classes in which cross-references might be essential. After the substantial necessity for such cross-reference has been determined, it should be noted on the blue slip. On the upper left hand margin of the sheet of drawing the examiner places the following "(O.G.Fig....)", indicating by numeral the figure which has been selected for illustration in the Official Gazette. (See description of this publication under "Official Gazette", page 51). There should also be indicated on the lower right hand margin the number of figures on the drawing. On the lower margin of the drawing the examiner will write the allowance mark and the date allowed, thus: ".... .,", (inserting date where dashes are). He will also fill out the form at the bottom of the face of the file wrapper. The number of claims to be printed is subject to change, but one claim being printed as a rule, at present, 1920. This applies to reissue cases also.

The blue slip is not used in unrevised classes, otherwise the procedure is the same.

The application should be carefully inspected with Order No. 2438, Nov. 18, 1918, in view. While this order directs the primary examiner to have the clerk revise the entire application, it is evident that it is primarily the duty of the assistant examiner to see that the application is in every way in condition for allowance before he places it on the clerk's desk for revision by her.

In so revising the application, and in subsequent revision and proof reading in the Issue and Gazette Division and in the Printing Office, minor informalities are sometimes found which must be corrected, but which are not sufficiently important to warrant a continuance of the prosecution of the case before the examiner. These may be corrected by examiner's amendment, (See Order No. 2308, Mar. 12, 1917.) This amendment is made out on Form 2-254, and a copy is sent to the applicant. Where the correction is made in an application already in the printer's hands, or where it is trivial, as the misspelling of a word, it appears needless to send a copy to the applicant, and it is not done, the paragraph in the form concerning the applicant being canceled.

The file wrapper bears on the left hand margin the legend: "Division of Application No....., Filed.....,

19...". This is to be filled out with the serial number and date of any prior application of which the one in question is a division or continuation. But such is not the case if the application under consideration contains any matter additional to that contained in the prior application or if the prior application was at no time co-pending. In connection with this matter, see Order No. 2071, Sept. 19, 1913.

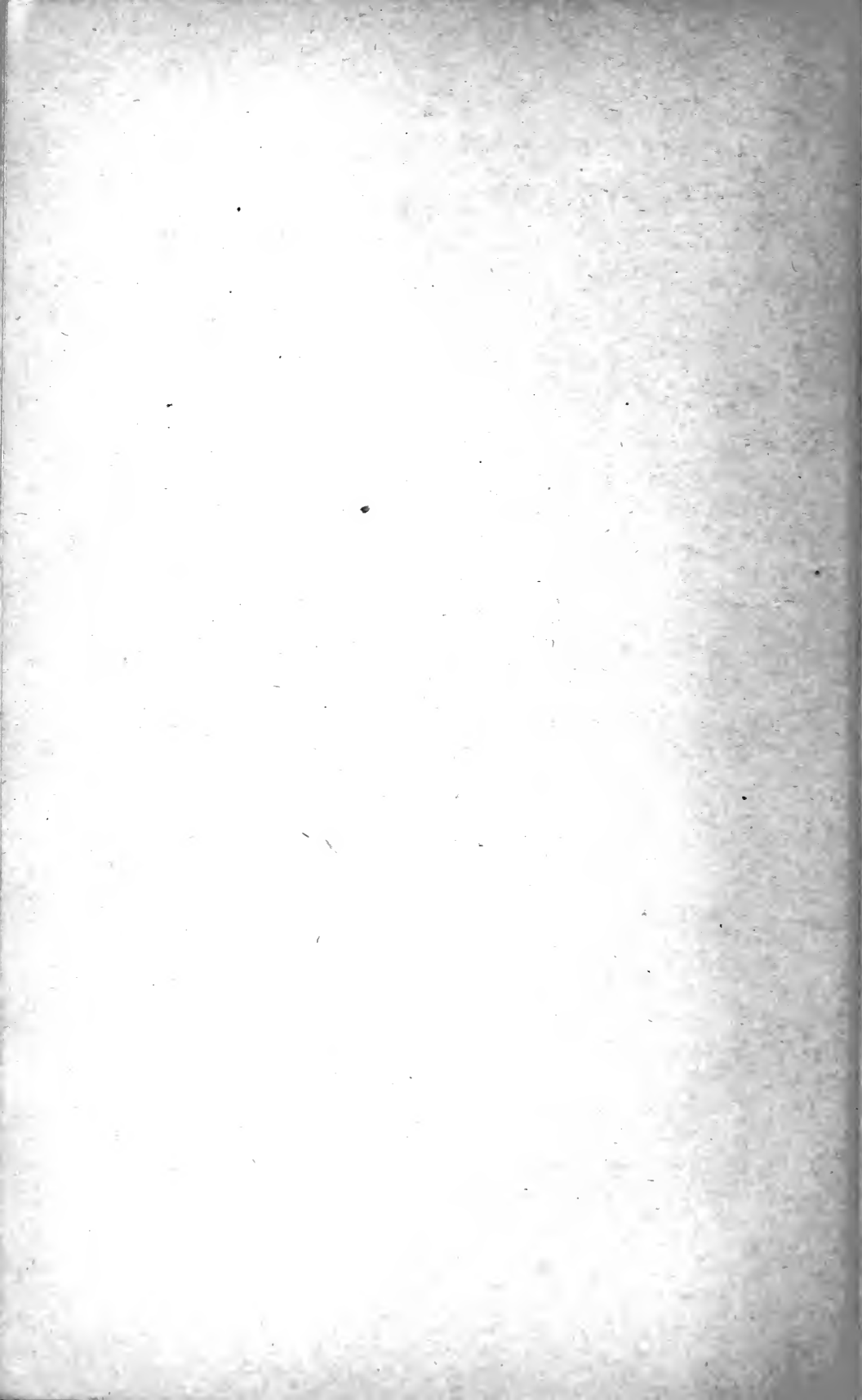
Where an application is a substantial duplicate, containing no additional matter, of one previously filed and **abandoned**, it should be endorsed on the file jacket as follows: "Refiled for (abandoned) application filed...., Ser. No.....".

The application is signed by the Primary Examiner after revision by the clerk under Order No. 2438, if no informalities are found. The clerk then enters in her register the date of allowance and gives the file to the copyist, while the drawings are placed in the appropriate drawer of issue drawings. The copyist fills out the notice of allowance, (Form 2-171 or 2-182, according to whether the final fee has been paid or not; or Form 2-184, in the case of a reissue application), places the original in the file and mails a carbon copy thereof to the applicant or his attorney. The name of the applicant, which must be typewritten in the upper left hand portion of the form, is followed, where there is an assignment, in this notice of allowance, by a comma followed by the expression "Assor. etc.". This shows that the patent will issue to the assignee. (See Chief Clerk's circular of Nov. 22, 1918.) The application is finally placed in the "Issue Box", and a messenger takes it to the Issue and Gazette Division. The application has then passed out of the jurisdiction of the Primary Examiner.

For procedure when notice of allowance is returned see page 28 ante.

In this connection the following order, (Order No. 1838, Jan. 13, 1910), is pertinent:—

"Whenever because of the death of an inventor the right of applying for and obtaining a patent for an invention devolves upon an executor or administrator, or whenever an executor or administrator desires to intervene prior to the granting of the patent, proof of the authority of such executor or administrator should in all cases be made of record in the assignment



records of this Office by recording a certificate of the clerk of a competent court or of the register of wills that said executor or administrator has been appointed and that his appointment is still in full force and effect. Such certificate should be signed by an officer and authenticated by the seal of the court by which the same is issued."

"Should said certificate of appointment be found to be insufficient for any reason, there may be required to be recorded a certified and properly authenticated copy of the letters testamentary or of the letters of administration, in order that the scope of authority of the persons who seek to intervene may be a matter of record in this Office."

"In order to insure the proper issuance of patents and in the interest of uniformity of practice, it is hereby directed that all applications filed by an executor or administrator or in which an executor or administrator has intervened or in which the death of the inventor has been suggested, be referred to the Assignment Division to ascertain whether proper authority is of record, and for suitable endorsement on the file before passing the case to issue. * * * In any case in which the Chief of the Assignment Division reports that the authority of the executor or administrator of record in the case is insufficient, the examiner will require the recording in the Assignment Division of a certificate of such appointment or a certified copy of a letter testamentary or of letters of administration in such case before finally passing the case to issue."

"It is further ordered that before passing a reissue application to issue the file be forwarded to the Assignment Division in order that the abstract of title forming part of the file record may be brought down to the latest date so that the examiner may ascertain therefrom whether the chain of title in the same is complete and to insure the granting of the reissue to the legal owner as required by section 4916 of the Revised Statutes. This order will apply also to cases of insane persons arising under section 4896, R. S."

The portion of the Order omitted above has been overruled by Order No. 2076, Oct. 14, 1913, which reads as follows:

"Where an inventor dies after filing an application, the executor or administrator should intervene, but the allowance of the application will not be withheld nor the application withdrawn from issue if the executor or administrator does not intervene."

CROSS-REFERENCES.

The blue slip referred to on a preceding page is used to indicate where cross-references are needed in revised classes. The cross-references so indicated will be mount-

ed, stamped, and sent to the examining division by the Classification Division.

To keep up the cross-references in unrevised classes, the examiner should look over the Official Gazette each week, and if any patents are found which he wishes to cross-reference to any of his classes, he will order a sufficient number of copies on Form 2-607 to make a complete copy when mounted, and send them to the paste room to be mounted. They will be mounted on stiff cardboard and returned to the division. The clerk of the division has the stamps for the unrevised classes, and will stamp them properly. They are then put in the proper shoes.

ACTION AFTER ALLOWANCE.

If a reference is found for an allowed claim in an application which has gone to issue, the Primary Examiner writes a letter to the Commissioner requesting that the application be withdrawn from issue for the purpose of applying the new reference. Upon the approval of this letter by the Commissioner, it is taken to the Issue and Gazette Division and the application is withdrawn from their files and stamped "Withdrawn" over the allowance signature of the Primary Examiner. It is then returned to the division from which it came, the clerk enters the withdrawal from issue on her register, and the application returns to its former status as a pending application. The examiner takes up the application at once and writes a letter stating that the application has been withdrawn from issue, and citing the new reference or references against the claim or claims believed to be met thereby.

AMENDMENT AFTER ALLOWANCE.

When an amendment is filed in the Office prior to the mailing of the notice of allowance of the application to which it is directed, but reaches the division that allowed the application after the mailing of said notice, the amendment must be entered. If the character of the





amendment is such as to re-open the prosecution, the application must be withdrawn from issue, see above. Otherwise the amendment is entered under Rule 78 with the written approval of the Commissioner. (See *ex parte Law*, C. D., 1904, page 292.)

An amendment received in the Office after the mailing of the notice of allowance should be accompanied by a petition under Rule 78, see page 48.

PETITIONS AND APPEALS, (Rules 78-171).

When petitions or appeals are received in the Patent Office they are forwarded to the Docket Clerk who sends for the file. In the case of a petition he enters the petition and forwards the file to the proper Law Examiner or to the Primary Examiner. It is forwarded to the Primary Examiner in case a statement is required from him and an order for such statement is attached to the file. The Examiner answers the petition and returns the file with his statement attached, to the Docket Clerk, who forwards it to the Commissioner after making a memorandum thereof. If the Examiner recommends adversely he also mails a copy of his answer to the applicant. Petitions are usually decided without oral hearing, but if such hearing is deemed necessary, a day is set and notices sent by the Docket Clerk. After the decision of the Commissioner, the petition is returned to the Docket Clerk who makes a record of the same and forwards the file to the Primary Examiner who will act in accordance with the decision.

PETITION UNDER RULE 78.

If the amendments proposed in a petition under Rule 78 are of a merely formal nature the petition is answered by a set form for which a stamp is found in every division. If the amendment goes to the merits and the Examiner does not believe the proposed amended claims patentable he is not required to make a re-examination but recommends adversely and states that a re-examination would be necessary if the amendment were admitted. As stated elsewhere, a copy of the recommendation must then be sent applicant, and the words "Copy sent" typed on the

original. If the amendment broadens the claims but the Examiner considers them patentable, he states these facts and recommends favorably. In this case no copy is sent to the petitioner. The Examiner should always state in his recommendation whether or not the final fee has been paid.

PETITION TO REVIVE.

In answering a petition to revive an abandoned application the Examiner should state the date when the application became abandoned, whether the amendment, if any, is responsive, and if not, in what respect it is defective, and whether it puts the application in condition for allowance. If no amendment is filed, or if the petition is not verified, the answer should so state. Attention should be called to the record so far as pertinent to the question of revival, but no recommendation should be made. A copy of the answer should be sent the petitioner. (See also notice of June 18, 1920, p. 31 ante).

APPEALS.

In the case of appeals, the Docket Clerk sees that the appeal fee has been properly applied, enters the appeal on the file and in the record of appeals, and forwards the file, with appeal attached, to the Examiner for answer to the appeal. On receiving the appeal, the Examiner orders three photographic copies of the drawings, and answers the appeal, copying in his statement all appealed claims. (See Order No. 1856, May 12, 1910.) He will recite in his statement all references on which he relies to support the actions from which appeal is taken, but no others. (See Order No. 2070, Sept. 16, 1913.) If he has found a reference not in the record of the case, but which he believes should be considered on appeal, he will cite such reference on the authority of *ex parte Mevey*, 56 O. G., 805, which outlines the further procedure in such a case. The date of the appeal and the answer thereto are entered in the clerk's register, and the file, with the Examiner's answer and the photographic copies entered therein, is forwarded to the Docket Clerk, who, if he finds



the file complete, forwards it with copies of the references cited, to the Board of Examiners-in-Chief, who set the case for hearing.

After the case has been decided by the Examiners-in-Chief, the file, with their decision, is returned to the Docket Clerk, who notes the decision on the file and in the record of *ex parte* appeals, and forwards it to the Primary Examiner. The Primary Examiner then takes the proper action to carry into effect the decision.

If the applicant appeals to the Commissioner from the decision of the Examiners-in-Chief, the appeal is sent to the Docket Clerk, who notes the date of the appeal on the file, and record is made thereof. The Docket Clerk checks up the copies of the references, sets the day of the hearing, and sends out notices of the day set. The file is retained by the Docket Clerk until the day of hearing. When decided by the Commissioner, the file is returned to the Docket Clerk, who notes the decision on the file and in the record of appeals. The decision is then recorded in full as is done in all decisions of the Commissioner on appeal. The file is afterwards forwarded to the Primary Examiner for proper action.

Inter partes appeals, (*interference*), are treated in substantially the same manner.

Cases wherein appeal lies to the Court of Appeals of the District of Columbia, are held by the Docket Clerk after the decision of the Commissioner, until the expiration of the time allowed for appeal when the files are returned to the Primary Examiner if no appeal has been taken.

If appeal to the Court is taken, the Docket Clerk selects those papers which should form the transcript record, notifies appellant of the papers selected, and forwards a list of the references to the Manuscript Division. The court, having decided the case, forwards the decision to the Commissioner of Patents and it is sent to the Docket Clerk, who enters the decision and makes a copy for publication in the Official Gazette. The file goes back to the Primary Examiner for proper action.

Carbon copies of all "Examiner's statements" in answer to appeals, and of all answers to petitions in which a copy is mailed to the petitioner, and also of the letter

written to the Examiner of Interferences in each interference, are kept on file in each division.

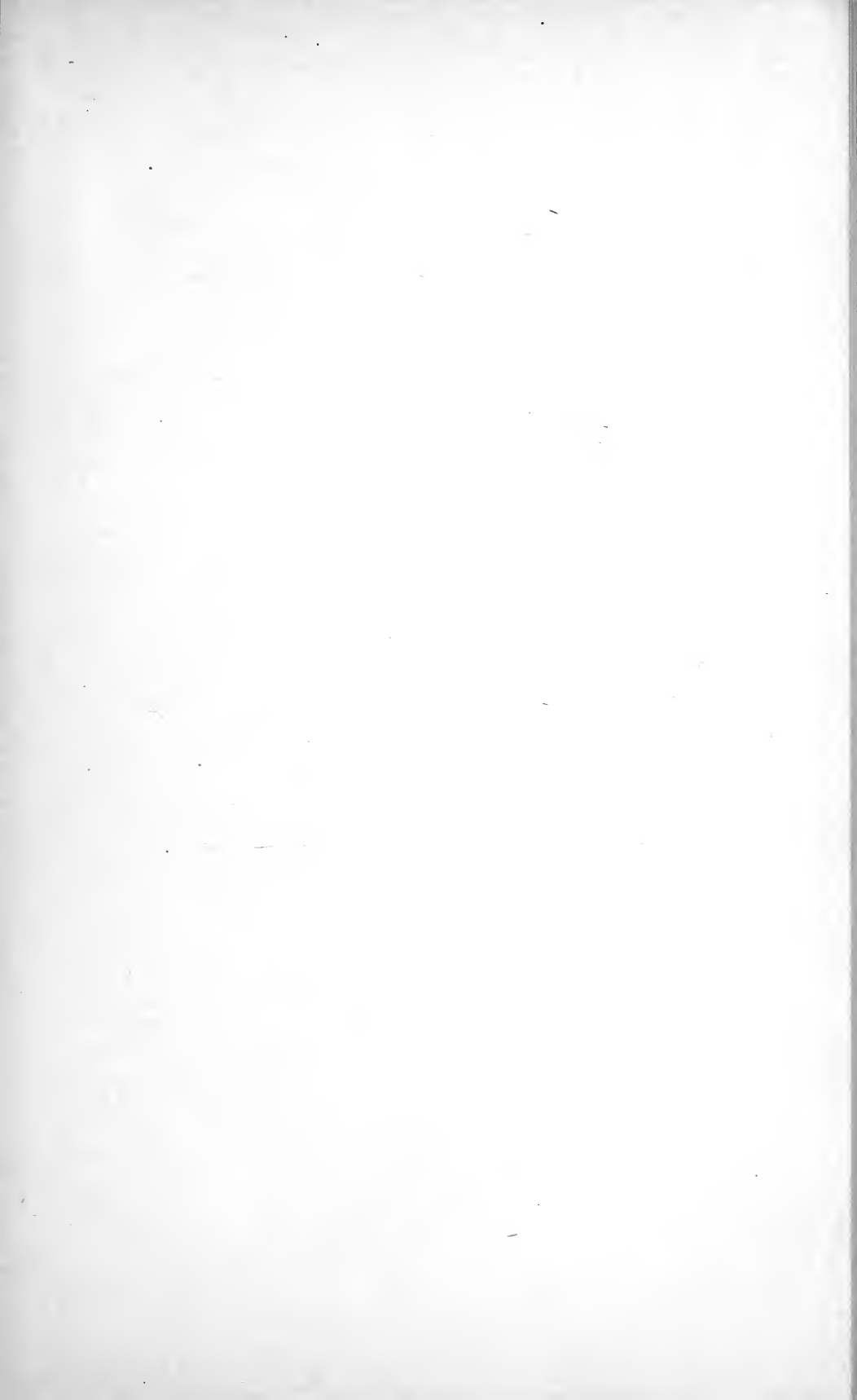
A record of all cases on appeal or involved in interference should be kept and the decision noted when it becomes final, so that the applications out of the division for these purposes may be found at once.

DIVISION AND ELECTION OF SPECIES.

Rules 41-44 refer to applications in which more than one invention is claimed in an application. In the application of these rules, the examiner is referred to *ex parte Eagle*, 1870, C. D., 9. When the examiner finds it necessary to make a requirement of division, or to call for election of species, he does not make a thorough examination of the art of the different inventions, but merely cites the best references he is aware of, or which a cursory search of the art reveals, such references being cited to aid the applicant in making his choice. In either case, the claims are rejected in view of the requirement of division or election of species. If applicant refuses to divide or to elect a single species, as the case may be, and the examiner retains the opinion that such action should be taken, the case is referred to the proper Law Examiner under Order No. 2215, Aug. 15, 1915. In such case, he writes a letter to the Law Examiner stating the facts of the case, and forwards the file, with the letter attached, to the Law Examiner. The Law Examiner renders a written decision, approving, disapproving, or modifying the examiner's action, and the examiner acts in accordance therewith.

In connection with this question, *ex parte King*, C. D., 1913, 105, should be studied. If applicant retains claims under *ex parte King*, he should be required to give his reasons for non-compliance, and a final requirement of division should be entered with the approval of the Law Examiner.

If after canceling claims to one invention, or to one specific modification, applicant in a later amendment inserts a claim to such invention or specific modification, the claim is not to be rejected, but the examiner requires that it be canceled. Should applicant refuse to do so, the case is referred to the Law Examiner as coming under Order No. 2215 referred to above.





SPECIAL CASES.

Cases having an effective filing date running more than three years are made special and are referred to a Law Examiner. See Order No. 2210, by June 28, 1915, and additional notice relative thereto, by former Assistant Commissioner Clay, Jan. 4, 1916, for procedure.

FORFEITED APPLICATIONS.

When the file of an allowed application is forwarded to the Issue Division, it is placed in the file cases of that division. If the final fee, (see Rules 167-174), is not paid within six months from the date of the notice of allowance, the file is withdrawn, and returned to the examining division. The clerk of the examining division takes out the drawings, stamps them "Forfeited", stamps the files likewise, makes the proper entry in the register, and forwards the file and drawing to Division E, (Abandoned Files), where they are recorded as forfeited applications and filed away.

ABANDONED APPLICATIONS.

At the expiration of each quarter the Primary Examiner has an examination made of the files in his division, to ascertain what applications have become abandoned through failure to prosecute the same within one year after the date when the last official action was made by the Office.

These applications are withdrawn from the files, the drawings assembled therewith, and the files and drawings stamped "Abandoned". The proper entry is made on the "Register of Pending Applications", and the files and drawings are forwarded to Division E, (Abandoned Files).

The Primary Examiner makes a report of the number abandoned, grouping them in accordance with the year in which they were filed.

RENEWAL APPLICATIONS, (Rules 167 and 174-176).

If a renewal is filed within two years from the date of mailing the notice of allowance, the file and drawings

are sent for by the Application Room, given a new serial number, and sent to the proper division for re-examination. The examiner should note that this is now a new application although entitled to the date of the original, and that the application is not bound by a division or election of species made in the original application.

The original power of attorney is sufficient.

If no renewal is filed within two years from the date of allowance, the application and drawing are sent by the Abandoned Files clerk back to the Examiner's division where they are stamped with the word "Abandoned", the proper entry made on the register, and then returned to be filed away among the abandoned files.

ISSUE OF PATENT.

When the final fee is paid within the time allowed by law, the fee is acknowledged by the Issue and Gazette Division, and checked off on the final fee book, the file is given a patent number and a date, (see Rules 164-69), and the card for the Official Gazette is made. (The drawing is obtained from the examining division, a charge being left for it, and compared with the file, which is carefully inspected as to date, assignment, and classification. The file and drawing are then sent to the Government Printing Office, where the heading is printed on the drawing, and the file and drawing are returned to the Issue Division.

The drawing is next sent to Division E, from which division it is forwarded to the photolithographer. The file goes to the Assignment Division, where it is examined as to assignments, and returned to the Issue Division. From there it is sent to the Government Printing Office for the printing of the specification. The proof is sent to the Issue Division for reading. All errors in the original file that are discovered in the Issue Division must be corrected by the examiner, and therefore in cases of apparent error the file with the proof is forwarded to him, attention being called on an attached slip to the supposed errors. If the examiner agrees as to the corrections to be made he makes out an examiner's amendment and has it entered, endorses the slip, and returns the file to the Is-



sue Division. A copy of this examiner's amendment is not mailed to applicant as the patent is in course of printing, and it is too late for any reply.

If the correction is of such nature as not to be curable by an examiner's amendment the application may have to be withdrawn from issue. This may sometimes be avoided if the attorney has his office, or a representative in Washington. If that is the case, he should be called in immediately, and the error may perhaps be corrected by an amendment under Rule 78.

The error may be such that the examiner does not feel warranted in correcting it without reference to the drawing. In such case consult Division E, where the drawing will be found, or at least information given as to when it will be returned by the photolithographing company.

If the examiner finds the specification correct as it stands, he endorses the slip to that effect, and returns the file to the Issue Division.

The proof having been corrected, it is returned to the Government Printing Office, where the requisite number of copies are made. These copies of the specifications are sent to the contracting photolithographing company. The company binds them with the copies of the drawing after which they are returned to the Patent Office.

The number of copies printed of each patent is:—

One on bond paper, accompanying the patent grant for the inventor.

Two on heavy paper, one for the examiner, and one for the Attorney's Room.

One hundred soft copies distributed as follows:—twenty-seven copies for foreign exchange; fifteen copies for sale to libraries subscribing to the same, (these are made up in weekly bundles of the entire issue and mailed to the libraries); one copy for the patented file, put in the jacket with the patented application, which is filed away in the Record Room for reference; one copy for the bound volumes of patents kept in the Record Room; one copy for temporary volumes kept in the Record Room until permanent volumes are bound; one copy, of the specification only, to be used for reproduction; fifty-four copies delivered to the Publication Division for sale and official use.

The blank form of the patent grant is filled out in the Issue and Gazette Division, and the bond paper copy of the drawing and the specification placed therein. The

patent is ribboned and sealed before going to the Commissioner for his signature. After he has signed it, it is returned to the Issue Division, from which it is mailed. The patent is mailed to the attorney of record, unless there is a request to mail to the applicant or to the assignee.

Upon receiving the examiner's copy of a patent belonging to any of the classes he examines, the examiner will note in ink on the figures of the drawings any important points of the device which are not apparent on inspection, and place the copy on the Primary Examiner's desk. The copy will be returned to the examiner after inspection.

REISSUE, (Rules 85-92).

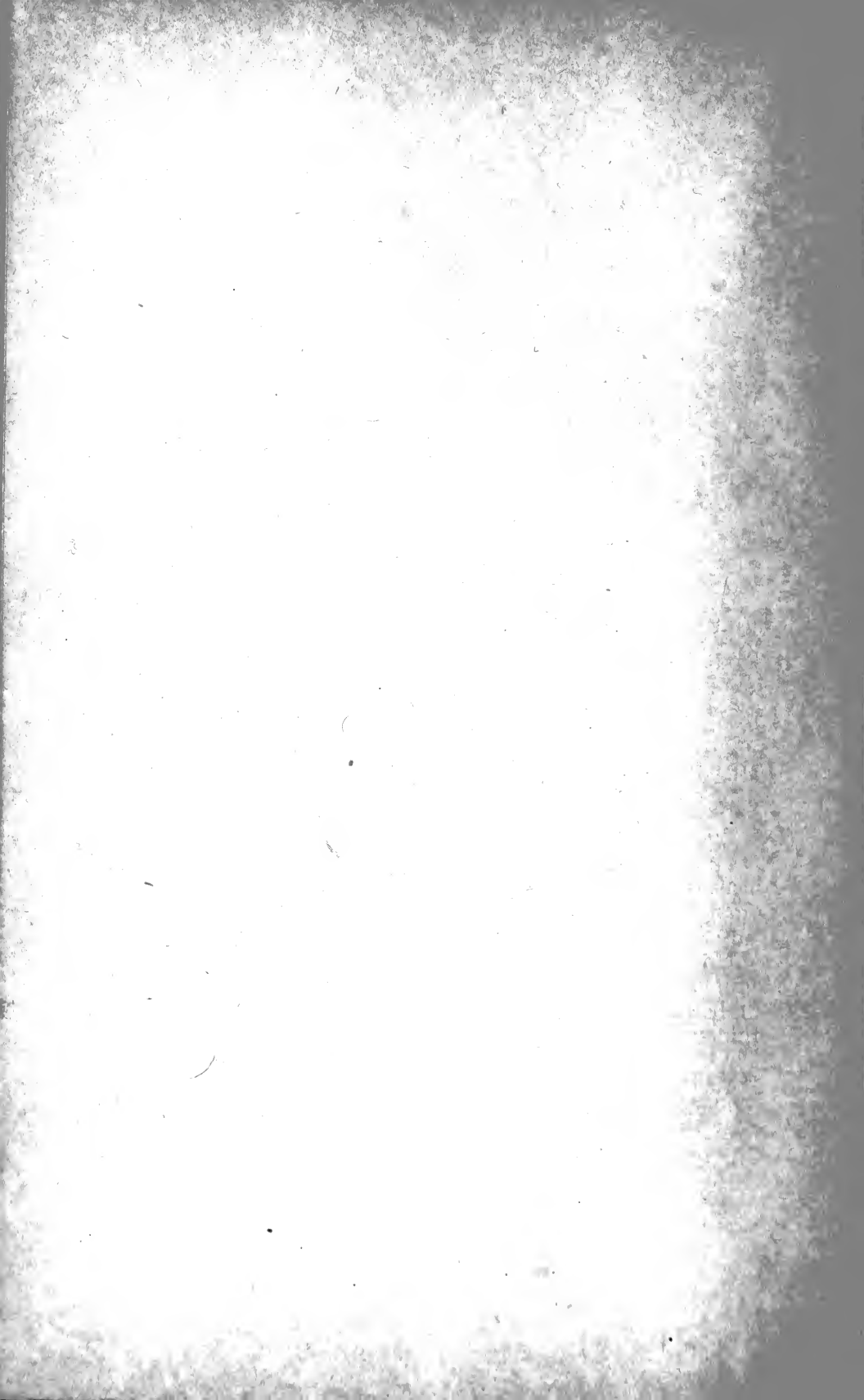
The oath required by Rule 87 must be submitted to the Law Examiner and the examiner is bound by his decision. Note Order No. 1838, Jan. 13, 1910, (p. 36 ante) as to the matter of referring applications to the Assignment Division.

Care should be exercised in examining the drawings in a reissue application to see that the drawings are made on a scale not smaller than the scale used in the original drawing unless a reduction of scale is authorized by the Commissioner. See Rule 53.

INTERFERENCES, (Rules 93-132).

If on an issue search, or in the course of the prosecution of an application, the examiner finds two or more applications by different inventors between which he believes an interference to exist, and one of which is ready for issue, he will draw up a schedule showing the claims of each party that he believes the other is entitled to make, and if necessary, modified or additional claims that might be made by two or more of the applicants. The examiner then writes a letter to the Law Examiner, giving the data of the applications, embodying the schedule, and requesting a conference with reference to the proposed suggestion of claims. If any two or more of the applications involved in the proposed interference are assigned to the same assignee, he calls the attention of the Law Examiner to that fact. (See notice of April 18,





1919, and form attached thereto.) This letter and a carbon copy thereof is forwarded to the Law Examiner, and when he is ready, he sends for the examiner. If the Law Examiner decides that no interference exists, the applications ready for issue are allowed. If the Law Examiner approves the letter as it stands, or in a modified form, he indicates this both on the original and on the copy, and returns the files and the carbon copy of the letter to the examiner who proceeds accordingly. The original of the letter is retained by the Law Examiner, and the copy is filed away by the Primary Examiner. In case the Law Examiner believes the claims to be suggested are not patentable, he gives his reasons to the examiner. If the latter still maintains the patentability of the claims, the Law Examiner may refer the matter to the Commissioner. The Law Examiner may retain the files while he carries on the correspondence provided for in Rule 93. When the files are returned to the examiner, he suggests claims in accordance with Rule 96, noting that copies of the letter suggesting claims are to be sent to applicant and the assignee as well as the attorney, and that if two parties have the same attorney, the applicants and the attorney are to be notified of that fact.

If one of the applications to which claims are to be suggested is in issue, the examiner writes a letter suggesting such claims to the applicant, stating that if such claim is made within a certain specified time the case will be withdrawn from issue, the amendment entered, and the interference declared. **Such letter must have the approval of the Commissioner.**

When the examiner suggests a claim appearing in a case in issue to an applicant whose application is pending before him, the case in issue will not be withdrawn for the purpose of interference unless the suggested claim shall be made in the pending application within the time specified by the examiner. If the suggested claims are made, a letter is written to the Commissioner requesting that the application in issue be withdrawn for interference purposes. When signed, this letter is taken to the Issue and Gazette Division with the file. The file is then stamped "Withdrawn", and the examiner has jurisdiction of it. In either of the cases noted, the Issue and Gazette Division should be notified to prevent application

of the final fee. (See Order No. 1858, May 23, 1910.) The issue file is usually borrowed by the examiner before the letter suggesting claims is written, a charge slip is left for it, and it is kept on the examiner's desk until returned or withdrawn.

When an application is found having claims to be suggested to other applications already involved in interference, the Primary Examiner writes a letter addressed to the Commissioner requesting jurisdiction. A separate letter is written for each file and refers only to that file, and is placed therein. This letter goes to the Examiner of Interference for his approval before being forwarded to the Commissioner.

When jurisdiction of the interference is requested, the letter is addressed to the Examiner of Interferences.

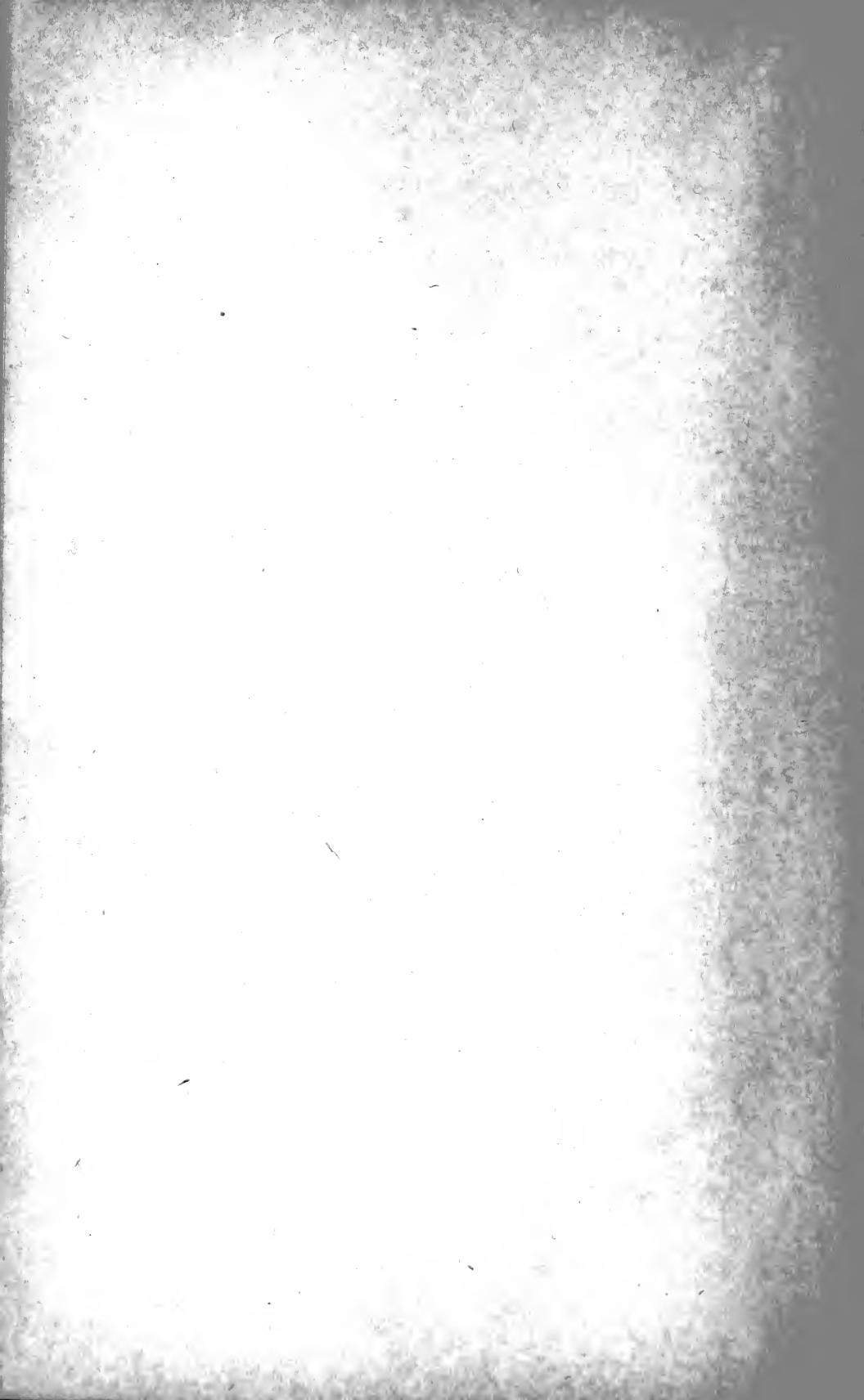
When the Primary Examiner asks jurisdiction of the interference for the purpose of adding a new party, the Examiner of Interferences informs the parties to the interference of that fact.

The Primary Examiner may withdraw the interference at any time prior to the opening of the preliminary statements referred to in Rule 110.

If the suggested claims are made before the expiration of the period set, the examiner will proceed in accordance with Rule 97. If the claims are made after the expiration of the time set, he will refer the case to the Law Examiner.

In preparing the notices of interference, the examiner should consult Order No. 1514, Jan. 26, 1903, and inspect the blanks, (2-213 and 2-251), upon which the notices are written.

In arranging the files in the inverse chronological order of their filing, the examiner considers the applications **directly involved** in the interference, leaving the question whether there are earlier applications by either party which may constitute legal proof of earlier invention, for subsequent determination by the Examiner of Interferences. The examiner should, however, call the attention of the Examiner of Interferences to any earlier applications by either party which it is thought may be considered proof of earlier invention of the subject-matter in issue. This may be done in the letter to the Examiner



of Interferences. (Raulet and Nicholson v. Adams, 1905, C. D., 55).

When the examiner is of the opinion that claims appearing in any of the applications to be put into interference are not patentable over the issue, he should append to the declaration a statement that such claims, (specifying them by number), will be held subject to the decision in the interference. This statement is made to each party with reference to claims appearing in his application, but it is not to be included in the letter to the Examiner of Interferences. (See Notice of May 11, 1917, by the First Assistant Commissioner.)

The examiner should see that photographic prints of the drawings in each case are made and placed in the files so that the original drawings may remain in the division during the interference proceedings.

When prepared, the files are sent to the Docket Clerk, who puts all the files in an envelope or a box, and gives a number to the interference, which he places on the envelope or on the box. The Docket Clerk forwards this to the Interference Division, where the files and letters are inspected to see that the notices are in proper form. If not, the files and notices are returned to the Primary Examiner for correction. If correct, the Examiner of Interferences sets the date for filing of the preliminary statements, mails the notices, and returns the interference, which has by the mailing of the notices been formally declared, to the Docket Clerk, who notes the date set for filing the preliminary statements on the interference file and in the interference register, and who retains the file until the expiration of the time for filing the preliminary statements. He then forwards the file to the Interference Division where, after the preliminary statements are approved, times for taking testimony are set and the day of final hearing is set and notices are sent. The file is again returned to the Docket Clerk who notes the day set for hearing and retains the file to be forwarded again to the Interference Division for hearing.

After the final hearing, the Examiner of Interferences sends a copy of his decision to each interferant with date of limit of appeal, and sends the file once more to the Docket Clerk, who, if no appeal is taken, returns the

file to the Primary Examiner at the expiration of the time allowed for appeal.

Rule 132 states that when the files are returned to the Primary Examiner, he shall advise the defeated or unsuccessful party or parties to the interference, that their claim or claims which were so involved in the issue, stand finally rejected.

To avoid a confusion of this action with the usual final rejection, the examiner should study closely *ex parte* Lyon, C. D., 1906, 422.

It is important to remember that the right of interferants to inspect each other's files does not begin until the preliminary statements are opened and approved by the Examiner of Interferences, and that such right is terminated at the end of the interference.

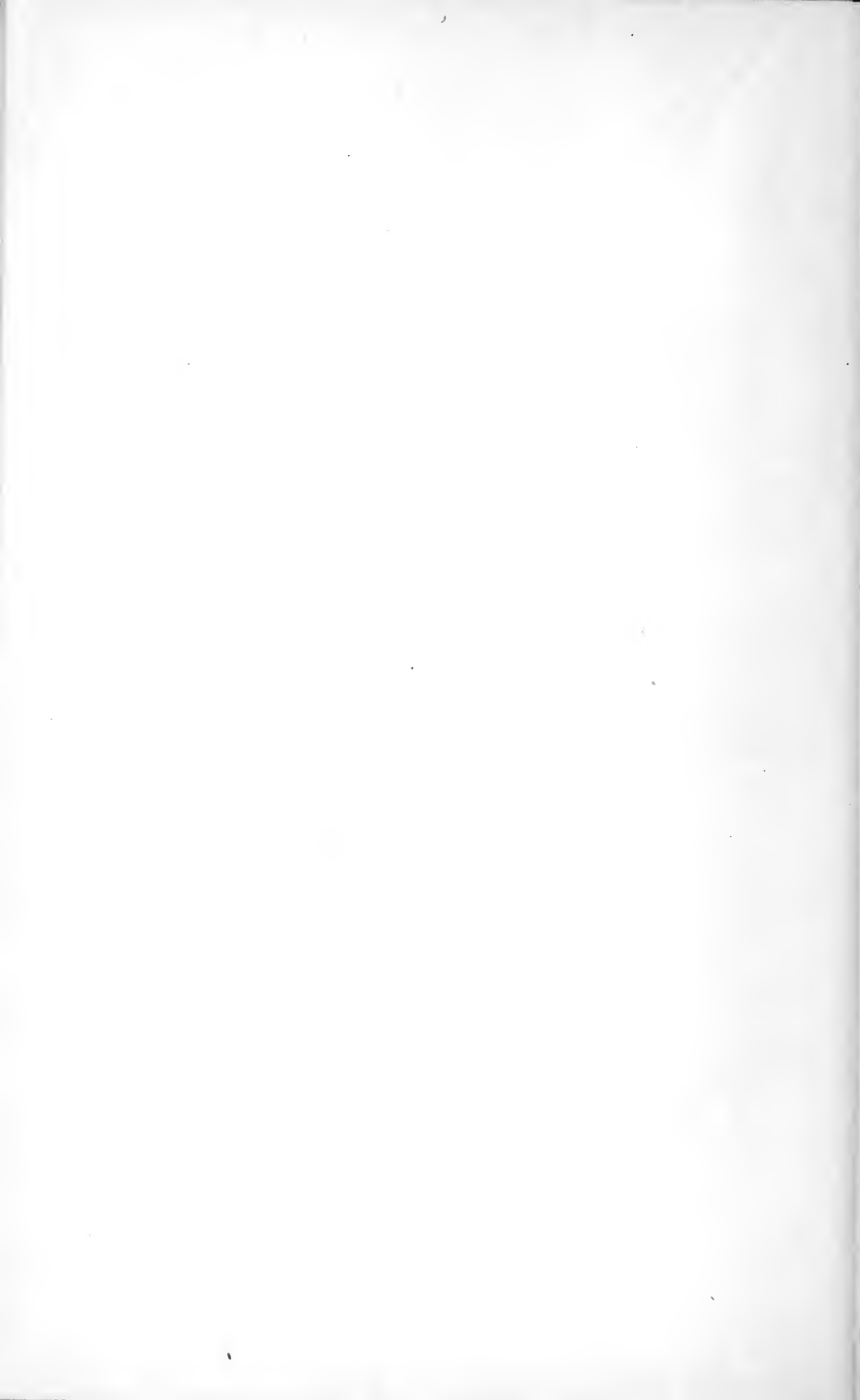
When an interference is terminated by an award of priority based upon the ground that one of the parties has no right to make the claims, and the other party files claims broader than those previously submitted, the application must be submitted to the Commissioner before entering the amendment.

It should be noted that Rule 128, pointing out the procedure in case a reference be found during the pendency of an interference, has been construed to cover cases in which it is found that a count of the interference does not apply properly to the disclosure of one party.

When amendments are filed to an application in interference, the Primary Examiner, unless they come within the excepted cases noted in Rule 109, has them marked in pencil, "Not entered", and placed in the file wrapper of the application, a corresponding entry being made on the wrapper. The clerk also makes a pencil note in the register. On the termination of the interference, these marks are erased, and the amendment entered and acted upon. (See Order No. 1759, April 17, 1908.) Amendments which place the application in condition for another interference may be entered.

RULE 75.

When an applicant files an affidavit under Rule 75 to overcome a reference which properly comes under that



Rule, the examiner will refer the same to the Law Examiner designated to judge as to the sufficiency of such affidavits, and the decision of the Law Examiner is binding on the examiner. (See Order No. 2255, May 18, 1916.)

The attention of the examiner is called to the wide difference in the character of the oath under Rule 75, and that called for by Rule 94 for interference purposes.

THE OFFICIAL GAZETTE.

The Official Gazette, which appears every Tuesday, contains the name of the applicant, and assignee, if any, filing date, the address of the applicant, and assignee, if any, the serial number of the application, the patent number, the title of the invention, the number of claims in the patents, and the class and sub-class, of every patent in a week's issue. One of the figures of the drawing, and one or more claims appear with this data. Trade-Marks, (published that notice of opposition may be filed), Trade-Mark Registrations Granted, and lists of Registrations of Labels and of Prints, are also printed in the Gazette. This forms the body of the Gazette, but as this is the only official publication of the Office, other matters are included in a few leaves bound with it, such as: important communications from abroad, notices to parties that the Office has been unable to reach by mail, disclaimers, adverse decisions in interferences, a statement of the condition of the work in the Patent Office, changes in the Rules, disbarments of attorneys, and the decisions of the Commissioner of Patents and the United States Courts, together with a list of adjudicated patents. These leaves are distributed separate from the Gazette, as well as included therein, and form the O. G. leaflets, one of which is placed on each examiner's desk when the Official Gazette is published.

The matter of the leaflets is arranged by one of the Law Examiners, but the arrangement and indexing of the Gazette is done by the Issue and Gazette Division.

“EXAMINER PREPARE ANSWER” LETTERS.

Communications are frequently received in the Office which are not of the nature of actions or attempted ac-

tions in the case, but are usually mere inquiries as to its progress. These are sent to the Chief Clerk, but as the nature of the inquiry is frequently such that the examiner in charge of the application is better able to answer it, these letters, where appropriate, are referred to him for answer. He first ascertains whether the writer is entitled to receive the information, and if he is, the letter is answered on the regular form, (2-260). The answer, with a carbon copy, (**both** signed by the Primary Examiner), and the correspondence in view of which the answer is written, are placed in an envelope exhibiting the address of the party to whom the answer is to be sent, and forwarded to the Chief Clerk. The words, "Chief Clerk", should be typed immediately beneath the printed matter appearing at the upper left hand corner of the envelope.

A statement indicating that an application is open for further prosecution when such is the case, should be included in answer to inquiries as to the status of the case. Enclosed stamps are mentioned as returned. (See Notice of June 3, 1918, and circular of Feb. 12, 1919.)



APPENDIX

(Orders and Notices referred to, but of which the substance is not given in the text.)

Order 1455, Feb. 4, 1902.

It is hereby ordered that no erasures be made or any note, interlineation, or other mark in pencil or otherwise, except by formal amendment duly signed, in the body or written portions of the specification or of any other paper filed in an application for patent.

It is further directed that no change be made by any person in any record of this Office without the written approval of the Commissioner of Patents.

Attorneys, employees of the Patent Office and all others will be held to strict accountability for any violation of this order.

F. I. ALLEN, Commissioner.

Order No. 1514, Jan. 26, 1903.

To make uniform the divergent practices in declaring interferences in accordance with the rules, it is hereby ordered:

1. That the letter to the Examiner of Interferences shall be written upon the blank (2-251) for that purpose. This letter shall contain, first, the information as to the parties required by the rules; second, the counts of the interference; and, third, the counts, when there are more than two, tabulated with the respective claims made by the parties. For example, in an interference X v. Y v. Z:

The relation of the counts of the interference to the claims of the respective parties is as follows:

Counts:	X:	Y:	Z:
1	16	3	2
2	5	1	3
3	9	15	5
4	4	11	6

2. That the letters to the different parties shall be written upon the blanks for that purpose and after the printed matter upon said blank, there shall appear, first, the counts of the interference; second, the information of the other parties, as required by the rules; and, third, the counts and claims of the parties tabulated as above. For example, after the counts, the letter to X would read:

- (a) The interference involves your application above identified and,
- (b) An application for Bicycle Saddle filed by Y, of 282 Broadway, New York, whose attorney is —, of —, and whose assignee is —, of —.
- (c) An application (patent) for Bicycle Saddle filed by Z, of 1205 Chestnut Street, Philadelphia, Pa., whose attorney is —, of —, and whose assignee is —, of —.
- (d) The relation of the counts of the interference to the claims of the respective parties is as follows:

Counts:	X:	Y:	Z:
1	16	3	2
2	5	1	3
3	9	15	5
4	4	11	6

3. In no case shall a letter be written on both sides of the sheet, or, with the exception of the letter to the Examiner of Interferences, be dated. All letters, except that to the Examiner of Interferences, shall contain the words "Forwarded to the Examiner of Interferences from Div. —, (date) —," either stamped or typewritten in the upper left hand corner, and also when there is an assignee or a patentee, it shall be stated on the original letters to be kept in the files, that a copy has been sent such party or parties.

4. All letters, both those for the files and those to be mailed shall be forwarded as required by the rules, the originals separate from the files, and the carbon copies to be mailed preferably attached to their respective envelopes, but in no case to be folded or placed within the envelopes.





5. Blue prints of the drawings and interference cards shall be placed in the files of the respective parties.

6. To secure prompt declaration of interferences, the papers should be forwarded to the docket clerk not later than Thursday of each week.

F. I. ALLEN, Commissioner.

Order No. 1733, July 19, 1907.

Hereafter all papers in applications must be arranged and marked uniformly in the following manner:

The specification and all amendments that are to be printed must be kept separate from office letters, appeals and miscellaneous correspondence. The specification and amendments must be fastened to the second or middle page of the packet with the original specification and claims on the bottom and the last amendment on the top. Office letters and other papers not needed by the printer must be fastened to the third page of the jacket, the last communication being on top. A communication containing amendments and explanations should ordinarily not be divided. If the amendments and explanatory matter be presented in the same paper, it should be treated as an amendment and placed on the amendment side, or second page of the jacket, care being taken so to mark and enclose the parts to be printed by red ink that the printer can readily distinguish the amendment from the explanatory matter. All the papers in the case will be numbered serially as heretofore.

Amendments will be lettered serially in the order of their receipt, all the amendments of the same date bearing the same serial letter. If the amendment is short, it should be transcribed in red ink at the proper place, and the notation "per A", "per B" &c., should be written in red ink on the margin. Amendments that are transcribed should never be marked A¹, A², B¹, B². Amendments that are too long to be transcribed should be marked A¹, A², B¹, B², &c., on the margin, the first amendment of this character in amendment sheet "A" being A¹, the second, A², &c. At the margin point at which the amend-

ment is to be inserted should be written "Insert A¹", "A²", &c., as the case may be, and the same letters placed in the angle of a caret at the proper point of insertion, so that when several insertions are placed in the same lines these different insertions may be readily distinguished.

All insertions and substitutions should be marked on the original application, if practicable. For instance, if Amendment A provides that claims 1 to 5 should be canceled and new claims substituted, a red line should be drawn transversely across claims 1 to 5 and in the margin should be written "Sub A¹". If at a later date the claims contained in Amendment A¹ are canceled and a series of claims contained in Amendment B¹ are substituted, the claims in Amendment A¹ should be canceled and the proper notation made in the margin, and in addition the notation "Sub A¹" on the original paper should be canceled and in its place should be written "Sub B¹". The last requirement is very important, as the work of the printer is needlessly delayed and complicated if he is compelled to search from paper to paper for the proper insertion.

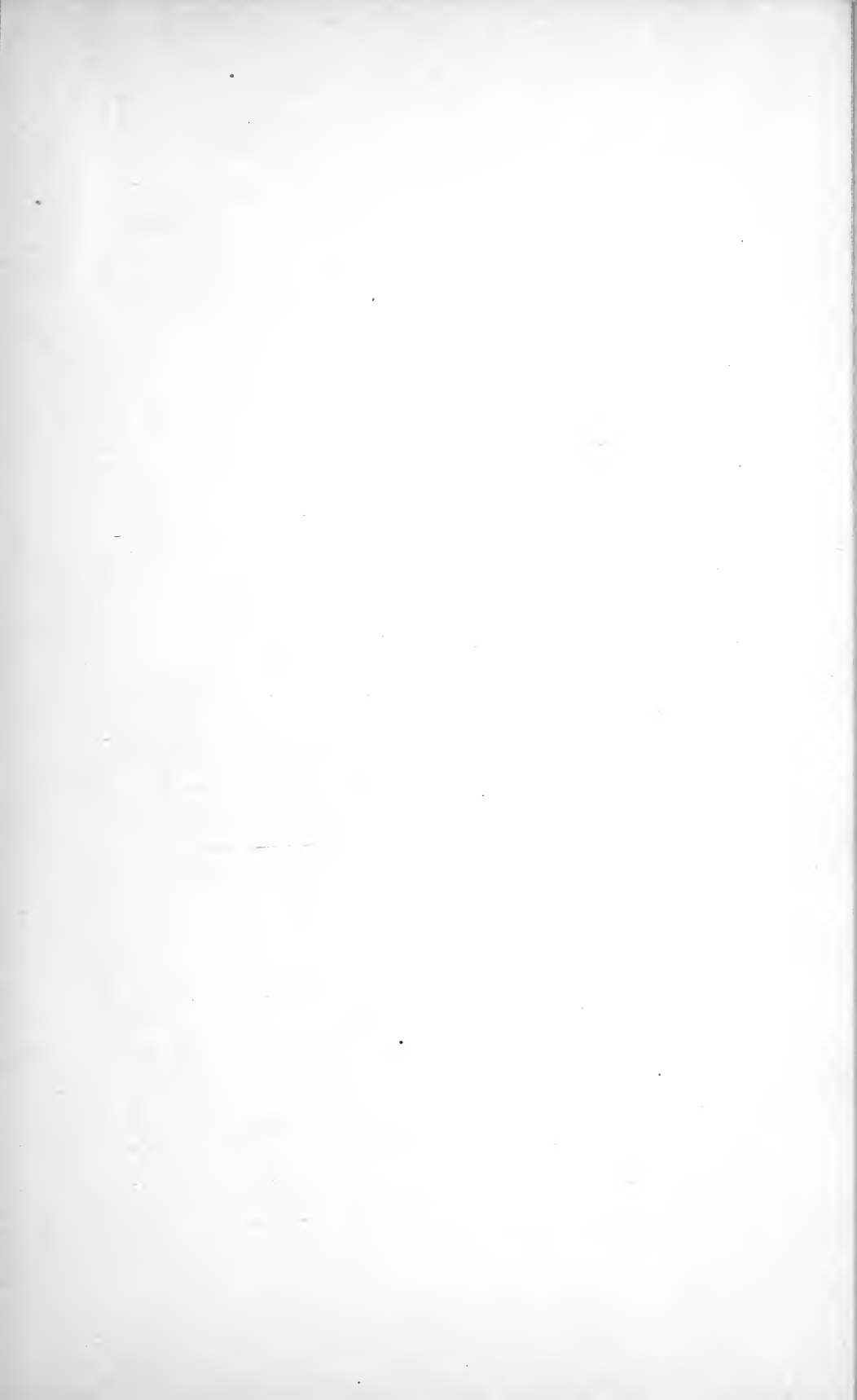
If amendments are submitted in duplicate, the word "Duplicate" should be written or stamped across the duplicate copy and it should be placed with miscellaneous papers on the third page of the file jacket.

All these rules will be strictly enforced and any application papers not prepared and arranged in conformity with them will be returned to the examiner for correction. Any deviation from these rules will be charged against the efficiency record of the clerk performing these duties. In case the clerk is in doubt regarding the manner in which the papers should be marked and arranged, full information may be obtained from the Chief Clerk.

E. B. MOORE, Commissioner.

Order No. 1759, April 17, 1908.

Instructions to primary examiners regarding amendments and other papers filed with them relating to interferences and applications involved therein:



(1) In order that amendments filed while an application is involved in an interference proceeding may not be overlooked after the interference is terminated, the primary examiner is directed to have all such amendments, unless they come within the excepted cases noted at the end of Rule 109, marked at once in pencil "Not entered" and placed in the file-wrapper of the application, and a corresponding entry made on the file-wrapper. A note should also be made in the examiner's register of office actions and amendments. After the termination of the interference these temporary entries shall be erased and the amendments permanently entered and considered as in the case of ordinary amendments filed during the ex parte prosecution of an application.

(2) In order to avoid confusion and loss of papers relating to interference matters pending before him, the primary examiner is directed to have all such papers stamped with the date of their receipt and entered in their proper order in the interference file.

(signed) E. B. MOORE, Commissioner.

Order No. 1961, Mar. 1, 1912.

Where an unsigned or improperly signed amendment is received, and there is not sufficient time for the return of such amendment for signature before the expiration of the time allowed by law within which to take proper action, the examiner will indorse such informal amendment on the file wrapper and notify the applicant of the status of the case.

Informal amendments which are to be returned will be forwarded to the Chief Clerk with a memorandum giving the name and address of the attorney, the date of the last Office action in the case, and a statement as to why the paper is to be returned. The Chief Clerk will cancel the impressions of the receiving stamps and conduct the correspondence incident to the return of the papers.

EDWARD B. MOORE, Commissioner.

Order No. 2071, Sept. 19, 1913.

Order No. 2010 of October 18, 1912, is modified as follows:

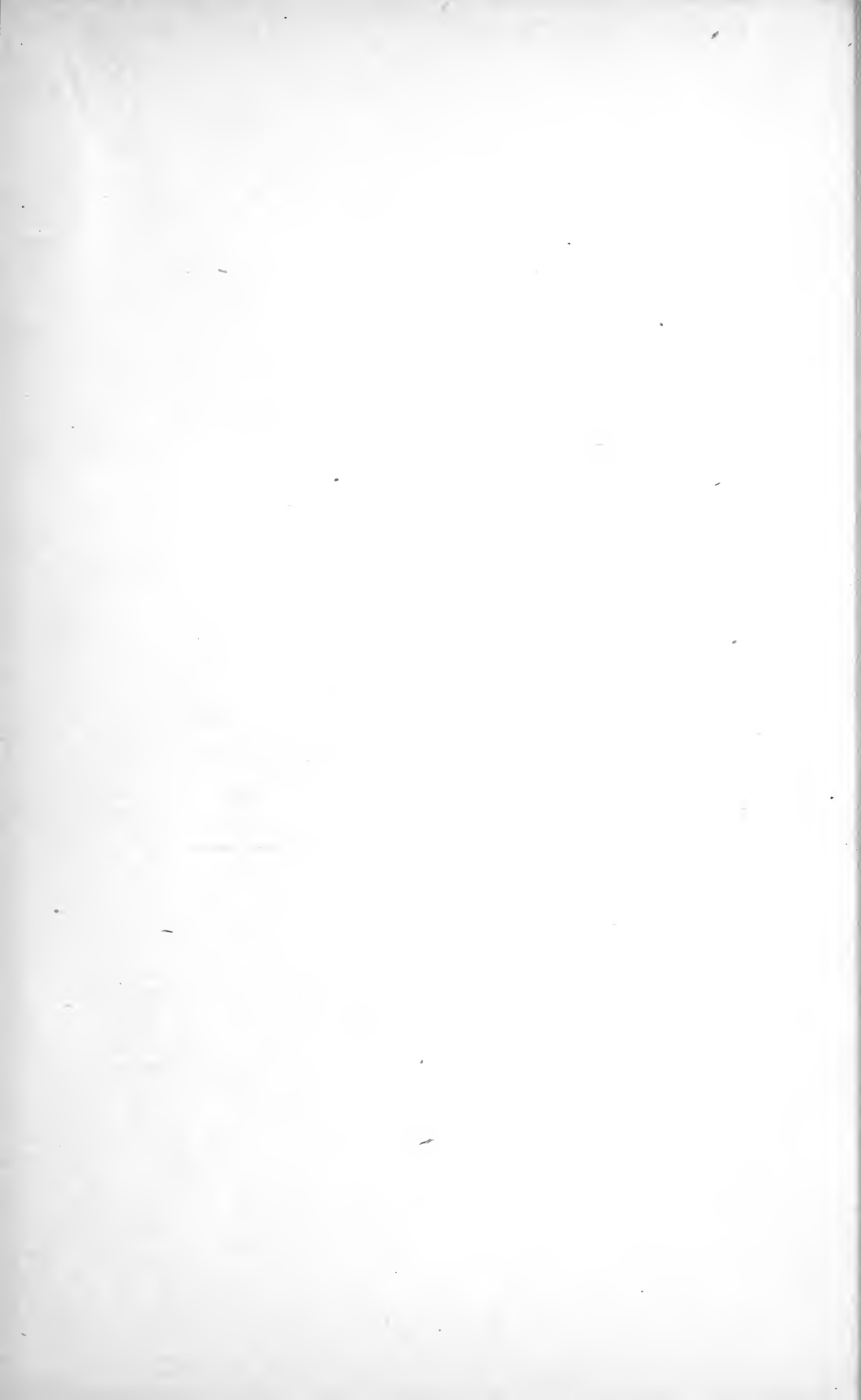
When an application is filed which in the opinion of the examiner is a continuation of, or a substitute for a previously filed application, the examiner will not require applicant to insert a reference to the prior application in the specification, it being regarded as sufficient if his reference appears somewhere in the record of the application. The examiner will make the appropriate entry upon the face of the file wrapper. The heading of the printed patent will conform to this entry.

THOMAS EWING, Commissioner.

Order No. 2207, June 23, 1915.

Hereafter copies of foreign patents sent from the library to the examining divisions will be listed on a triplicate slip (Form 2-568), the sheets which will be headed, respectively, "Receipt for.... patent received from the Library by Division; Classification of patents for the Library by Division....; Invoice of....patents sent by the Library to Division...." Upon the receipt of the foreign patents, the examiner will stamp the receipt portion of the slip with his division dating stamp and return it to the library messenger. Within 30 days from the receipt of the foreign patents, the examiner will return to the library any patents which he believes improperly assigned to his division, with the classification portion of the slip upon which he shall have canceled the numbers of such patents and upon which he shall have indicated opposite the number of each patent which is retained in his division the class and subclass in which it has been placed. The invoice portion of the slip will be retained by the examiner as a record of the patents received by his division.

Transfers of foreign patents will be made by the use





of the regular transfer blank (Form 2-566) under the supervision of the examiner of classification.

Where the transfer is within the division, both the class from which and the class to which the patents are transferred will be noted on the transfer blank, and one portion thereof sent to the library and the other retained for record in the division.

Where the transfer is from one division to another, the first division will note on the transfer blank only the class and sub-class from which the patents are taken. The first portion of the transfer blank will then be sent to the library and the remaining portions sent to the second division with the patents to be transferred. The second division upon the receipt of the patents will note on the transfer blank the class and sub-class to which the patents are transferred. One portion of this transfer blank will then be sent to the library, another to the division from which the patents were transferred, and the third retained for record.

When a change is made in the classification of the inventions, the transfer of the foreign patents affected must be made within 60 days from the date of the classification order.

THOMAS EWING, Commissioner.

Order No. 2210, June 28, 1915.

After January 1, 1916, all applications which have been pending for more than three years or which have an effective filing date running more than three years shall be made special and any amendment or other action therein by or on behalf of the applicant which does not put the application in condition for allowance or final rejection shall be submitted to a Law Examiner for his approval of its entry.

THOMAS EWING, Commissioner.

SPECIAL CASES.

Commissioner's Order No. 2210:**January 4, 1916, 222 O. G., No. 1, p. 1.**

To the Examiners:

In order to make the practice uniform, it is suggested that Examiners ordinarily report by brief letter, stating age of the application and why final action is not possible, accompanied by an attached copy of the action proposed to be taken if amendment be entered, (thus to avoid recopying the letter to the applicant). The applicant should be advised that the case is "special", and urged to amend promptly.

F. W. H. CLAY, Assistant Commissioner.

Order No. 2308, Mar. 12, 1917.

Order No. 1718, dated June 8, 1907, is hereby superseded by the following:

It is hereby ordered that, except by formal amendment duly signed or as hereinafter provided, no corrections, erasures, or interlineations be made in the body or written portions of the specification or of any other paper filed in an application for patent.

Obvious informalities in the application may be corrected by the examiner, but said correction must be in the form of an amendment, approved by the Principal Examiner in writing, placed in the file, and made a part of the record. The changes specified in the amendment will be entered by the clerk in the regular way.

It is directed that no other changes be made by any person in any record of this Office without the written approval of the Commissioner of Patents.

Attorneys, employees of the Patent Office, and all others will be held to strict accountability for any violation of this order.

THOMAS EWING, Commissioner.



Order No. 2438, Nov. 18, 1918.

It is obvious that when an allowable application leaves an examining division for the issue division, it should be in condition for issue. For a long time, however, a number of clerks in the issue division have been carefully revising all allowed applications. This practice has entailed very considerable delays, unnecessary duplications of labor, extra messenger work and added opportunities for the loss of files and drawings. In order to eliminate these objections, the following procedure will hereafter be followed:

Before affixing his signature to an allowable application, the primary examiner will direct his clerk to carefully revise the entire application as required by the accompanying set of directions. When the application is found by the clerk to meet the requirements prescribed, she will so advise the examiner who will then, and not until then, affix his signature to the file. The examiner's typist will thereafter prepare and attach to the third fold of the file wrapper an original notice of allowance (Form 2-181) and will mail, on the day of its dates, a carbon copy thereof, after endorsing that date upon the face of the file wrapper. The file will then be forwarded to the issue division. The drawing, if any, will be retained in the examiner's room.

The expensive operations of printing and photolithographing are the next essential steps and they will hereafter follow without any intermediary agency for the detection of errors. All persons affected by this change are asked to perform their new tasks with due care. An undivided responsibility will henceforth rest upon divisions from which allowable applications emanate.

Examiners should notify their clerks immediately upon ascertaining that an application is ready for final revision. The work of revision should be done as early in the week as possible. This will tend to ensure the counting off of actions as desired and will avoid a wholly unnecessary rush of work on report day.

Effective Nov. 25, 1918.

J. S. NEWTON, Commissioner.

Directions for Revision of Applications.

Initial both the file and drawing on back. If there are canceled sheets, initial last uncanceled sheet.

Compare serial number on the file, on each sheet of drawings, and on classification slip pinned to first sheet of drawings.

Compare initials and spelling of surname of inventor on all sheets of drawings, on file jacket, in preamble, and in signatures to the petition, specification and oath.

First name of inventor **MUST** be in full on file jacket and in preamble. It need not appear in full elsewhere (Orders 600, 2018), but where an apparent inconsistency appears an affidavit is necessary. **EX PARTE** Clark, 124 O. G., 910.

When a first name is given which appears to you obviously to be an abbreviation, not a Christian name, or one so seldom used otherwise that it must be presumed to be an abbreviation, and the file does not contain a sworn statement from the applicant that the name given is his full first name, refer the case to the Examiner for action under **EX PARTE** Bowen, 247 O. G., 245. If the Examiner considers the name given to be the correct, full, first name, fasten a statement to that effect, signed by him, in the file jacket.

A middle name or initial, or both, may appear in the record. Neither is necessary. If they appear, they must correspond to the extent of being consistent. A middle name or initial as signed to the specification must appear on the file wrapper.

Count figures of drawings and place number of figures on lower right hand margin of first sheet of drawing. See that there are no duplicate figures and no figures numbered in duplicate. Be sure **ALL** figures are described in specification, and that all figures which are described in specification appear on the drawing.

No drawing should be signed by an attorney entering the case after that drawing is filed, nor should the name of the attorney filing a drawing be erased therefrom (Order 480).

Canceled revenue stamps should appear on all powers of attorney filed between Oct. 22, 1914 and Sept. 8, 1916, inclusive, and also on those filed on and after Dec. 1, 1917, except powers of attorney executed abroad.

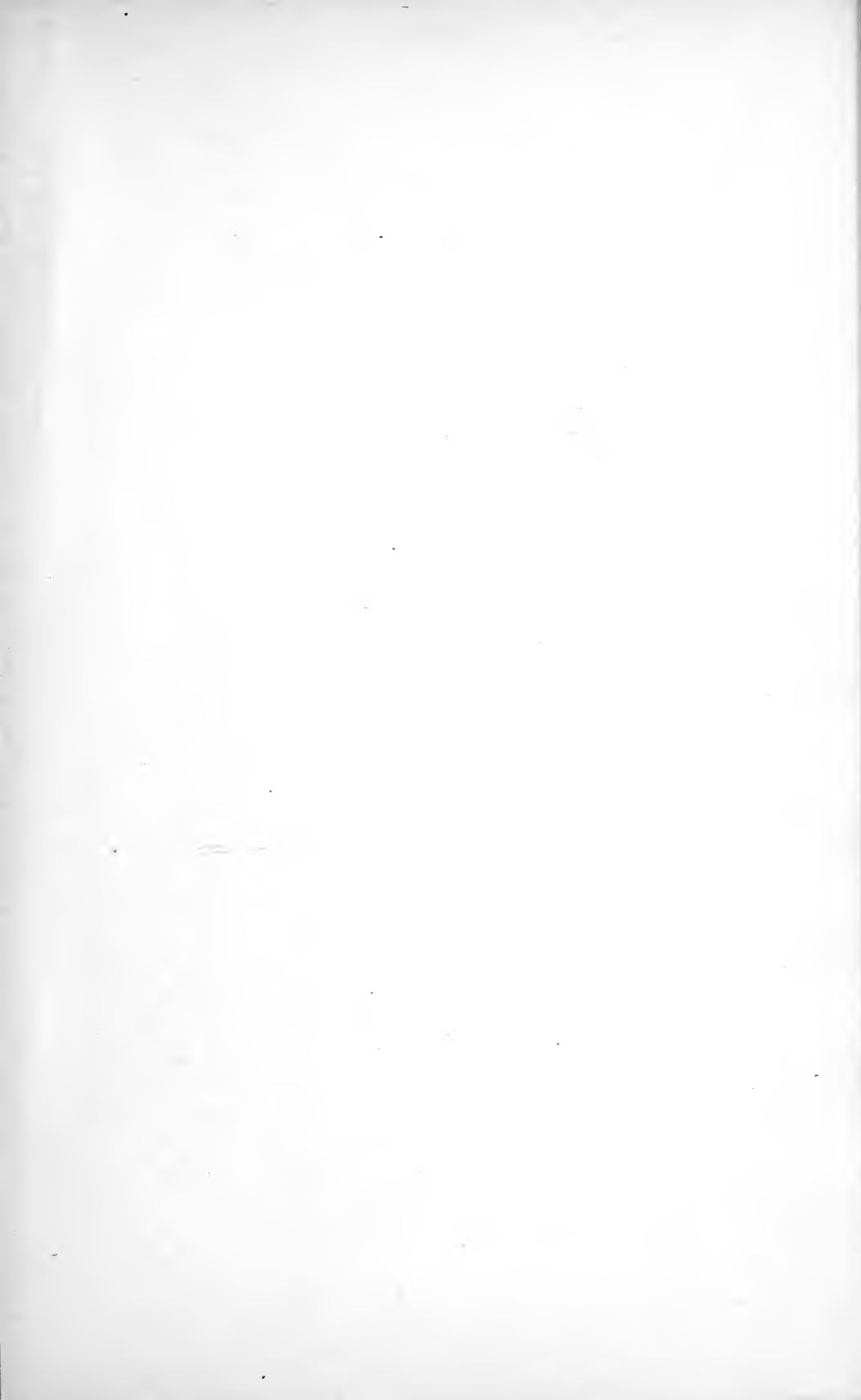


Figure to appear in Gazette must be noted on upper left hand margin of the sheet exhibiting the figure selected.

See that class and sub-class numbers are entered and agree on the file and on sheet 1 of the drawings in unclassified classes, and on the file and sheet 1 of the drawings and the blue slip pinned to that sheet in classified classes.

Have all penciled notes and interlineations on papers in the file jacket or on the drawings erased by Examiner. See Orders 560, 1455, 1718.

See that all uncanceled sheets of the drawing have draftsman's approval stamped on back.

See that the number of the examining division is plainly entered on file and at top margin, right corner, of all sheets of drawings.

Refer all drawings where there are sheets of drawings having (1) canceled figures, or (2) informalities, or (3) where it appears that there is room on an original sheet or sheets for figures presented on an additional sheet or sheets, or (4) where less than $1\frac{1}{4}$ inches of absolutely clear space remains for the printed heading at the top of any uncanceled sheet, to the draftsman, together with an attached slip indicating the matter upon which he is to pass, and requesting his approval or disapproval.

See that all accepted sheets of drawings are entered in the application, and the proper number of sheets noted on the face of file.

Compare title of invention on back of old form of file, or at bottom of present form of file jacket, with title in preamble to specification. They should agree.

See that date of "Application filed complete" is correctly entered on the face of the file jacket.

Compare residence on file jacket with that in preamble.

Count allowed claims and compare with number stated on file jacket.

One claim should be specified on file jacket for O. G. If more are specified consult examiner. (Order 2422).

In the oath, the jurat must be filled out, the word "sole" must appear if there be but one inventor, and "joint" if two or more inventors. An oath which refers to applicant as "the petitioner" need not contain applicant's name in the body thereof. When the person before whom the oath or affirmation is made in this country is

not provided with a seal, his official character shall be established by competent evidence, as by a certificate from a clerk of a court of record or other proper officer having a seal. The authority of any officer, not a U. S. minister, charge d'affaires, consul, or commercial agent, administering an oath to an applicant residing abroad must be proved by certificate of a U. S. diplomatic or consular officer. Rule 47. Venue and seal must agree. Note time between date of oath and filing of application. Three (now five)* weeks and time required for transmission in the mails is allowed (EX PARTE Branna, 97 O. G., 2533), but in divisional, continuation, substitute and reissue cases, this rule does not apply (EX PARTE Davison, 177 O. G., 241).

Foreign applications must be ribboned and the ends of the ribbon brought together under the seal of the officer administering the oath, or if not ribboned the seal must be on every sheet of the specification. Rule 47.

In divisional, continuation and substitute cases, see that the filing date and serial number of original application are on the margin of file jacket and agree with that given in the record of the application. (Orders 1832, 2010 and 2071).

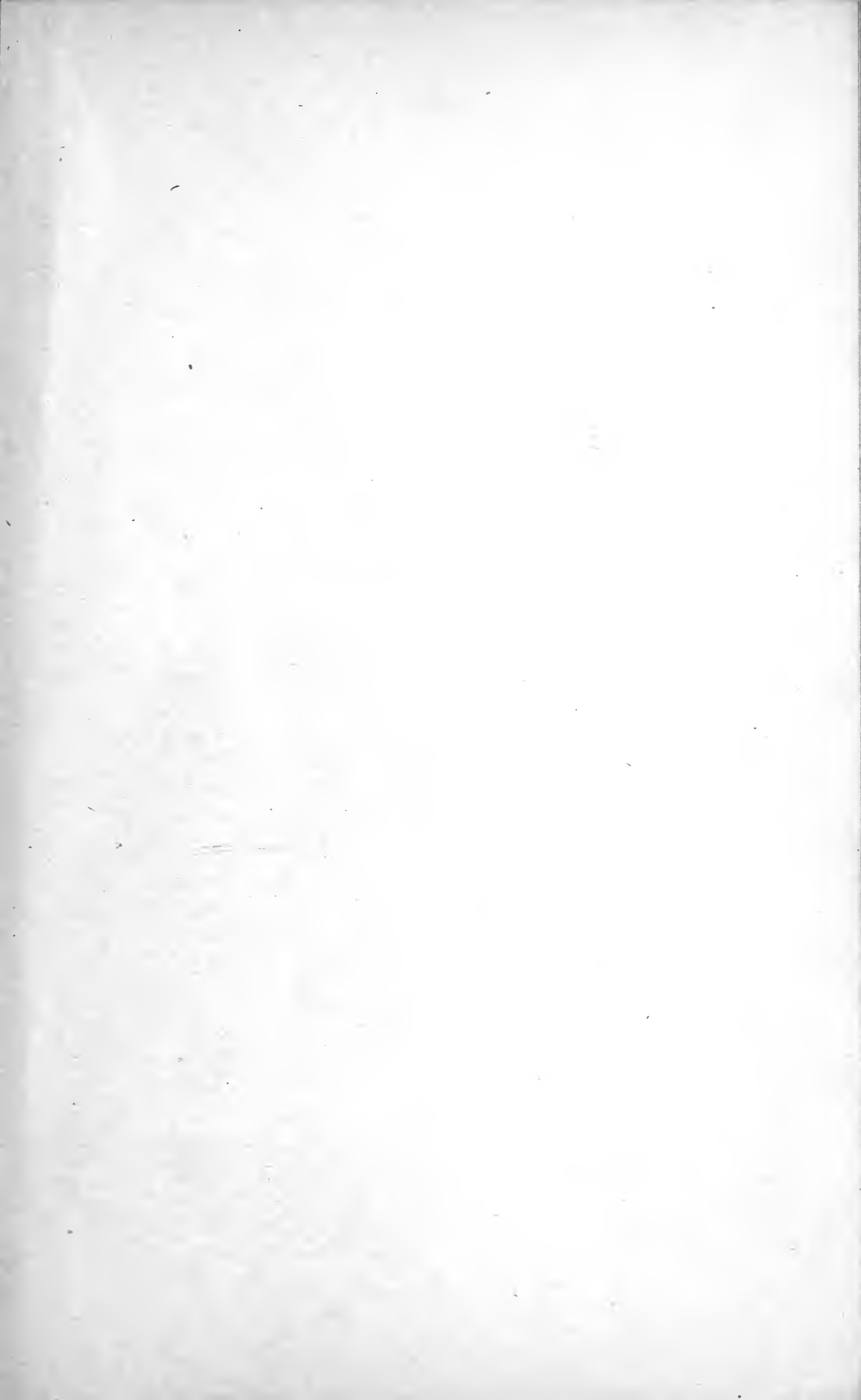
Send file, WITHOUT DRAWINGS, in all divisional, continuation, substitute and reissue cases, and cases where the record shows that the applicant is insane or shows or suggests that he is deceased, to Assignment Division for determination as to whether there may be any assignments, letters testamentary or letters of administration, etc., which should be entered on the face of the file wrapper, or for report as to title. (Order 1838). In reissue applications written consent of assignee, if any, to filing must appear and abstracts of title must be brought up to date of allowance.

The papers required by the printer should be on the second (middle) fold of the file jacket, and those not required on the third (right hand) fold, in numerical order. (Order 1733).

If a change has been made in the name or residence of the inventor by amendment, the file jacket should be corrected in red ink to correspond.

Check entries of all papers, examiners' letters and amendments, on back of file with file contents.

*Ex parte Heinze, 265 O. G., 145.





If inaccuracies are found, refer the case to the Examiner. Make no changes except in strict accordance with Order 1718.

Notice, February 20, 1918.

Attention is called to the order, a copy of which appears on page 4 of the Manual of Classification of January 1, 1916, forbidding the transfer of patents from one subclass to another or from one class to another, without approval of the Classification Division.

Such unauthorized transfers render the subclasses in the attorney's room no longer duplicates of those in the examiner's rooms, and also render incorrect the official subclass lists on file in Division F.

Examiners are directed to submit to the Classification Division all questions of transfer of patents.

J. T. NEWTON, Commissioner of Patents.

Notice, Apr. 17, 1919.

Submission of Proposed Interferences.

To Primary Examiners:

The accompanying form is suggested for submission of proposed interferences to the law examiner.

In preparing cases for submission to the law examiner and in subsequent treatment of the cases involved attention should be given to the following points:

(1) The name of the examiner to be called for a conference should be given as indicated on the form.

(2) It should be stated which of the applications is ready for allowance.

(3) If an application is a division or continuation of an earlier one, this fact should be stated.

(4) If two or more applications are owned by the same assignee, or are represented by the same attorney, it should be so stated. Where cases are prosecuted by

the same attorney or are owned by the same assignee and the claims of one application are restricted to patentably distinguish from the claims of the other, no interference need be suggested, but where the claims are drawn to the same patentable invention, all of the conflicting claims should be specified. Where an interference is proposed with a patent, before submission it should be determined from the assignment records whether the application and patent are owned by the same assignee.

(5) In the suggestion of counts only counts which are necessary to determine the question of priority should be selected; claims which are not patentable over the proposed claims should be omitted and the applicants should be advised when the interference is declared that such claims are not patentable over the issue and will be held subject to the outcome of the interference (see Notice of First Assistant Commissioner Whitehead, dated May 11, 1917). Claims are not patentably distinct unless they differ sufficiently to sustain separate patents. Where serious doubt exists as to patentable distinction the doubtful claims should be included. Cases should be thoroughly reviewed by the primary examiner.

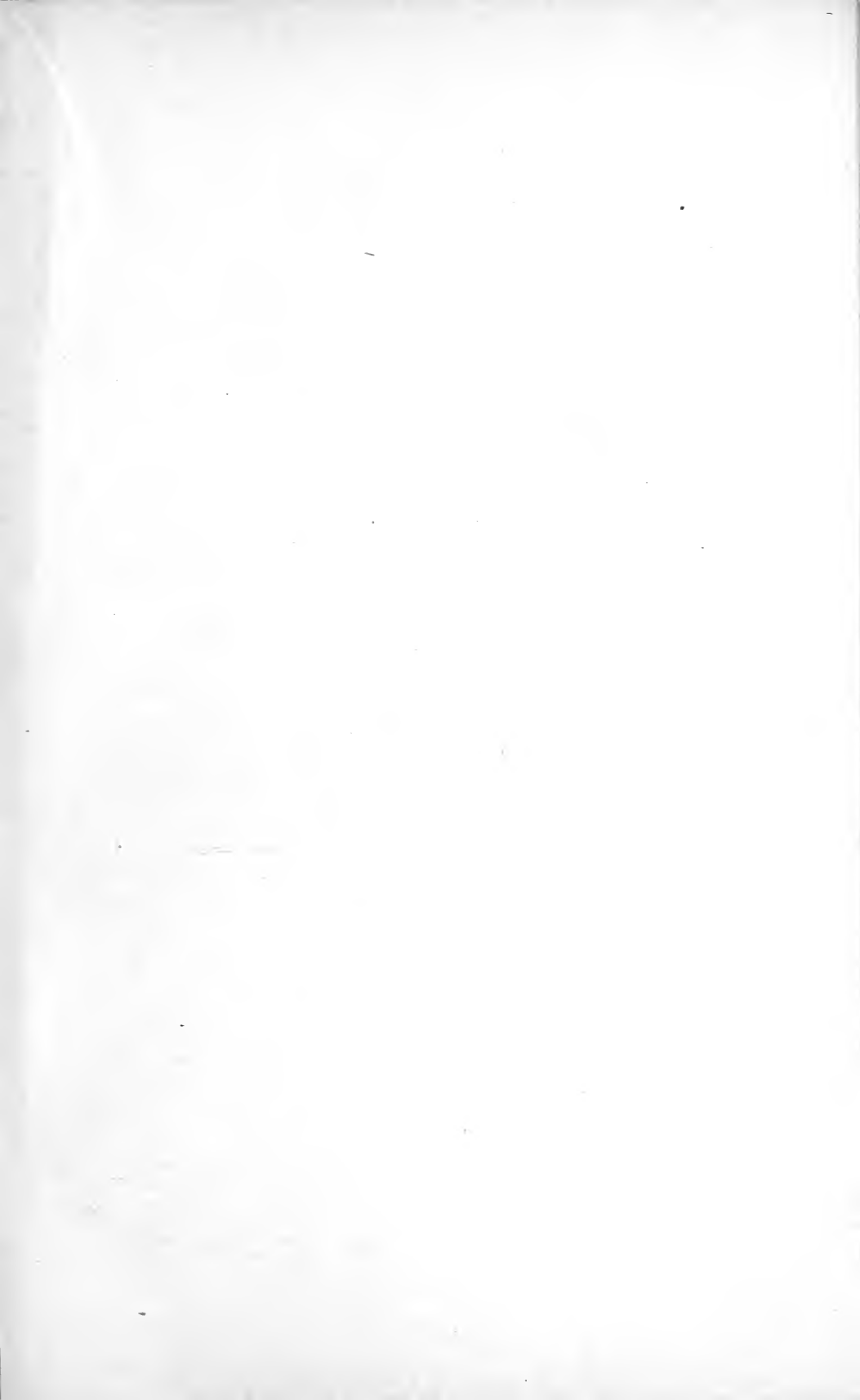
(6) Any other points which have a bearing on the declaration of the interference should be stated.

(7) Amendments or other papers filed in cases held by the law examiner should be promptly forwarded to him.

(8) Letters of submission should be in duplicate.

(9) Where there is a difference between the dates of applications of the senior and junior parties of about two months or more, the law examiner will require a statement from the junior party of his date of conception. If this date fails to overcome the filing date of the senior party, the senior application will be sent to patent as speedily as possible and the conflicting claims of the junior application will be rejected on the patent when granted. In the meantime the junior party's application will be acted upon or action suspended as the condition of the case requires. The interference will be disapproved only after the date of issue of the patent has been definitely determined.

J. S. NEWTON, Commissioner.





DEPARTMENT OF THE INTERIOR

UNITED STATES PATENT OFFICE

Washington

(Date)

Mr. L. D. Underwood,
Law Examiner.

Sir:

Conflict is found to exist between the following applications and it is proposed to suggest claims as indicated below:

156,202, F. A. Jones
203,503, T. A. Smith,
268,554, J. L. Myers,

The application of Jones is ready for allowance.

Taylor

Respectfully,

1st Ass't.

Examiner.

Jones	Smith	Myers
3 15 17	8 21 17	2 12 19

.....1.....

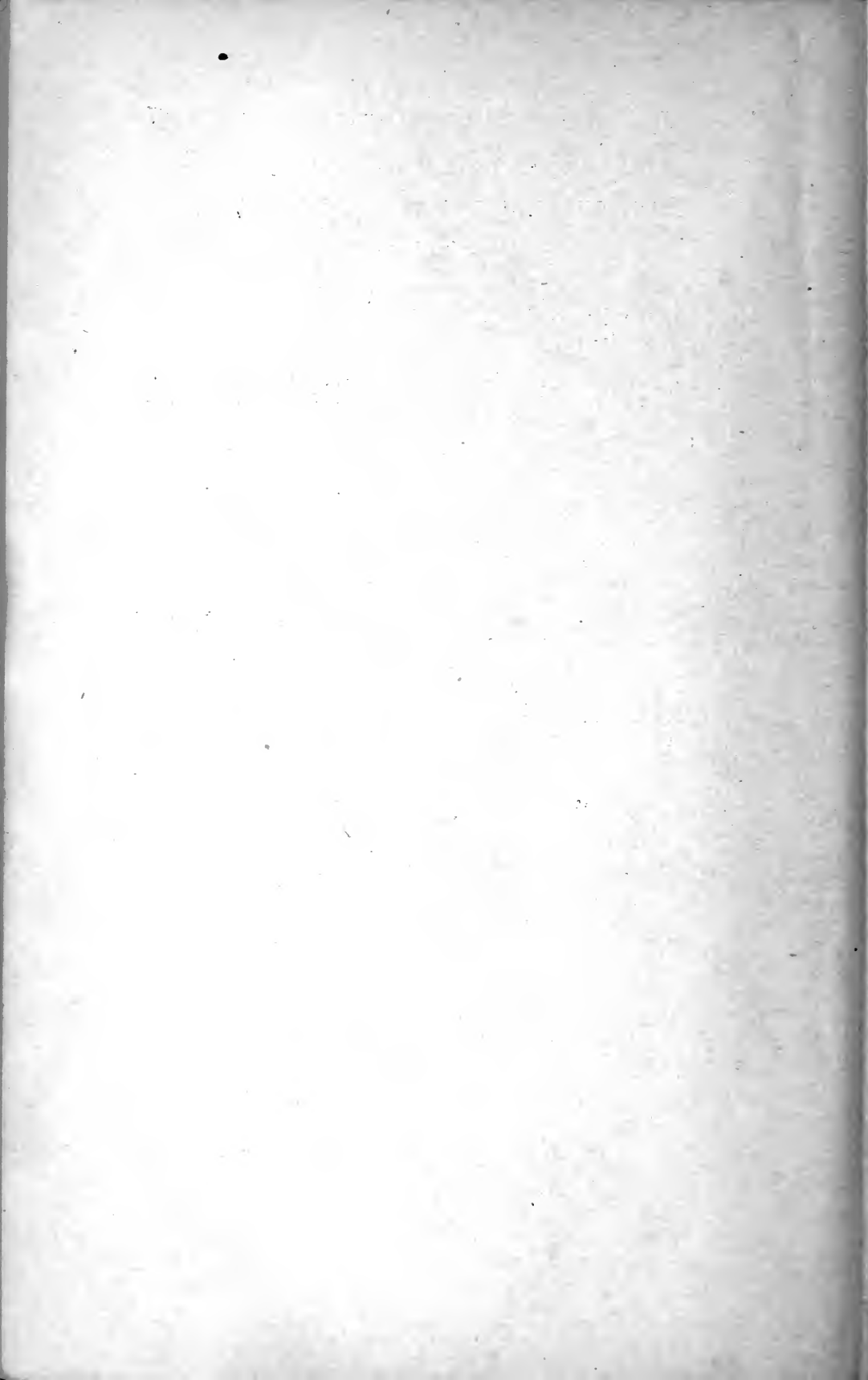
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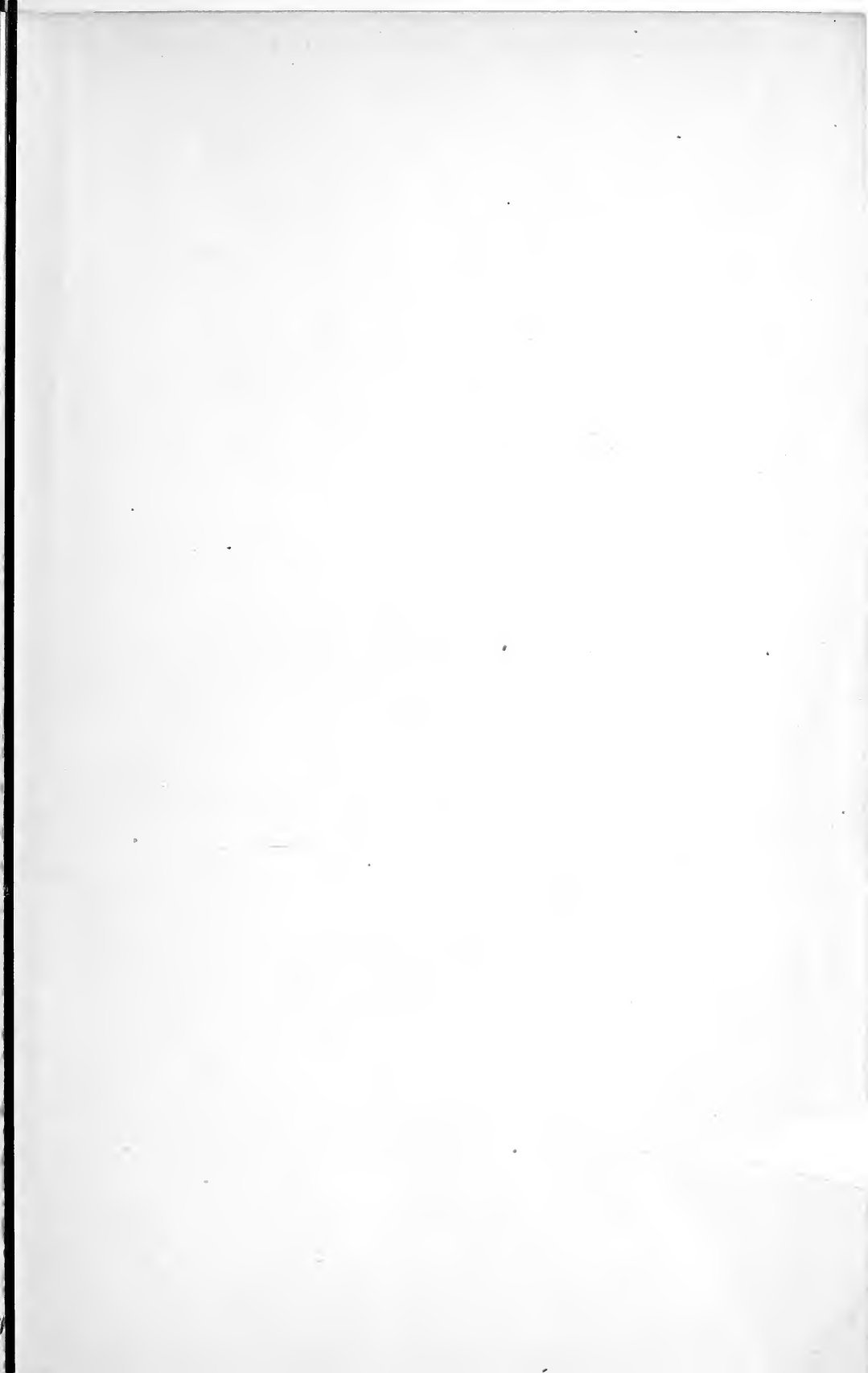
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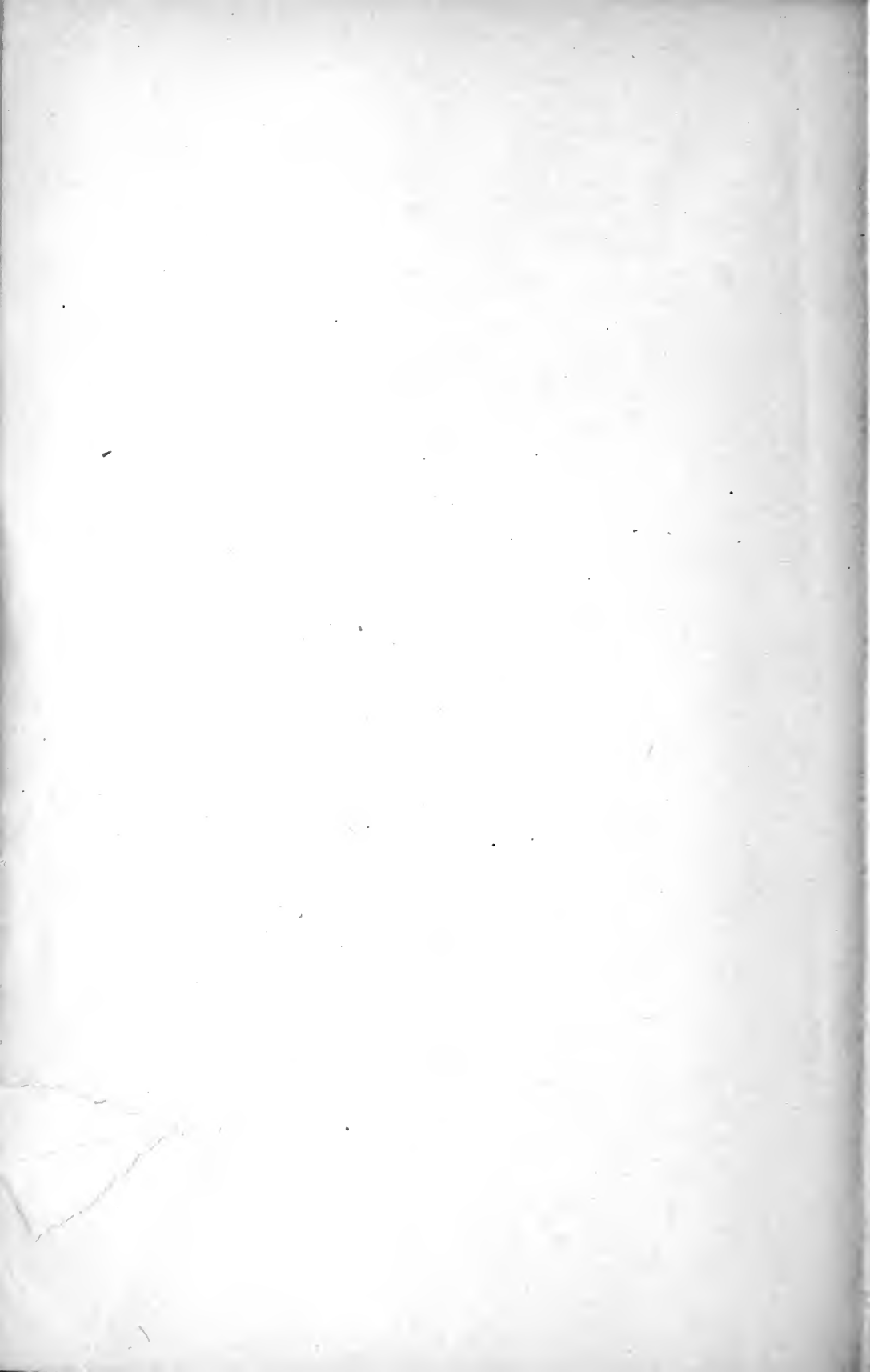
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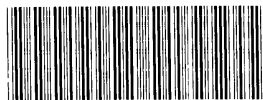








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